

**PATENTS ORDINANCE**

**專利條例**

# PATENTS ORDINANCE

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HONG KONG

ORDINANCE NO. 52 OF 1997

L.S.

I assent.

Christopher PATTEN,  
*Governor.*  
29 May 1997

An Ordinance to make new provision in respect of patents and related matters in substitution for the Registration of Patents Ordinance.

[ ]

Enacted by the Governor of Hong Kong, with the advice and consent of the Legislative Council thereof.

PART I

PRELIMINARY

**1. Short title and commencement**

- (1) This Ordinance may be cited as the Patents Ordinance.
- (2) This Ordinance shall come into operation on a day to be appointed by the Secretary for Trade and Industry by notice in the Gazette.

**2. Interpretation**

- (1) In this Ordinance, unless the context otherwise requires—  
“application for a patent” (專利的申請) means an application for a standard patent or an application for a short-term patent;

“court” (法院) means the High Court of Justice;

“date of filing” (提交日期)—

(a) in relation to a request to record or a request for registration and grant, means the date which is the date of filing that request by virtue of section 17 or 24 respectively;

(b) in relation to an application for a standard patent has the meaning specified in relation to that term in section 3(ii);

(c) in relation to a designated patent application, means the date specified as such in the designated patent application;

“employee” (僱員) means a person who works or (where the employment has ceased) worked under a contract of employment (whether with the Government or with any other person);

“employer” (僱主), in relation to an employee, means the person by whom the employee is or was employed;

“exclusive licence” (專用特許) means a licence from the proprietor or applicant for a patent conferring on the licensee, or on him and persons authorized by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application for a patent relates, and “exclusive licensee” (專用特許持有人) and “non-exclusive licence” (非專用特許) shall be construed accordingly;

“international application” (國際申請) means an international application for a patent made under the Patent Cooperation Treaty;

“International Bureau” (國際局) means the International Bureau of Intellectual Property provided for under the Convention Establishing the World Intellectual Property Organization signed at Stockholm on 14 July 1967;

“law of the designated patent office” (指定專利當局的法律) means—

(a) in relation to a designated patent office established under the law of any country, territory or area other than Hong Kong, the law of that country, territory or area;

(b) in relation to a designated patent office established under an international agreement, the provisions of the international agreement;

“mortgage” (按揭) when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;

“non-prejudicial disclosure” (不具損害性的披露) means, in relation to an invention, a disclosure of the invention which is not to be taken into consideration for the purposes of determining whether or not the invention forms part of the state of the art;

“opposition or revocation proceedings” (反對或撤銷專利的法律程序) means, in relation to a designated patent, proceedings under the law of the designated patent office providing for the revocation or amendment of the designated patent within a specified period after the grant;

“Paris Convention” (《巴黎公約》) means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883;

“Paris Convention country” (巴黎公約國) means—

- (a) any country for the time being specified in Schedule 1 as being a country which has acceded to the Paris Convention;
- (b) any territory or area subject to the authority or under the suzerainty of any country specified in Schedule 1 pursuant to paragraph (a), or any territory or area administered by any such country, on behalf of which such country has acceded to the Paris Convention;

“patent application” (專利申請) has the same meaning as an application for a patent;

“Patent Cooperation Treaty” (《專利合作條約》) means the treaty of that name done at Washington on 19 June 1970;

“patented invention” (專利發明) means an invention for which a standard patent or, as the case may be, a short-term patent is granted and “patented process” (專利方法) shall be construed accordingly;

“patented product” (專利產品) means—

- (a) a product which is an invention for which a standard patent or a short-term patent (as the case may be) has been granted;
- (b) in relation to a process for which a standard patent or a short-term patent (as the case may be) has been granted, a product obtained directly by means of the process or to which the process has been applied;

“prescribed” (訂明) means prescribed or provided for by rules made under section 149;

“protected layout-design (topography)” (受保護的布圖設計(拓撲圖)) has the meaning assigned to that term by section 2(1) of the Layout-design (Topography) of Integrated Circuits Ordinance (Cap. 445);

“register” (註冊紀錄冊、註冊)---

- (a) as a noun, means the register of patents kept under section 51; and
- (b) as a verb, means, in relation to any thing, to register or register particulars, or enter notice of that thing in the register and, in relation to a person, means to enter his name in the register,

and cognate expressions shall be construed accordingly;

“Registrar” (處長) means the Registrar of Patents;

“Registrar of Patents” (專利註冊處處長) means the person holding that office by virtue of the Director of Intellectual Property (Establishment) Ordinance (Cap. 412);

“registry” (註冊處) means the Patents Registry administered by the Registrar;

- “request for registration and grant” (註冊與批予請求) means a request under section 23 for the registration of a designated patent and the grant of a standard patent for the invention shown in the published specification of the designated patent;
- “request to record” (記錄請求) means a request under section 15 to record a designated patent application;
- “right” (權利), in relation to any patent or patent application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;
- “rules” (規則) means rules made by the Registrar under section 149;
- “short-term patent” (短期專利) means a patent for an invention granted under Part XV;
- “short-term patent application” (短期專利申請) means an application under Part XV for a short-term patent;
- “specification” (說明書), in relation to an application for a patent under this Ordinance, a designated patent application or an international application, means the description, claims and drawings contained in the application;
- “standard patent” (標準專利) means a patent for an invention granted under Part II;
- “standard patent application” (標準專利申請) means an application under Part II for a standard patent;
- “verified copy” (核實副本) means, in relation to a document, a copy verified in the prescribed manner;
- “World Trade Organisation Agreement” (《世界貿易組織協議》) means the agreement of that name done at Marrakesh in 1994;
- “WTO member country, territory or area” (世界貿易組織成員國、地區或地方) means any country, territory or area for the time being specified in Schedule I as being a country, territory or area which has acceded to the World Trade Organisation Agreement.

(2) The expressions listed in the left-hand column below are defined in, or fall to be construed in accordance with, the provisions of this Ordinance listed in the right-hand column in relation to those expressions.

Expression	Relevant Provision
Application for a standard patent (標準專利的申請)	section 3
Corresponding designated patent (相應指定專利)	section 4
Corresponding designated patent application (相應指定專利申請)	section 4
Deemed date of filing (當作提交日期)	section 38
Designated patent (指定專利)	section 4
Designated patent application (指定專利申請)	section 4

Expression	Relevant Provision
Divisional designated patent application (指定專利的分開申請)	section 22(1)
Government use (政府徵用)	section 69(2)
Paris Convention country (巴黎公約國)	section 98(6)
Patent (專利)	section 6(1)
Published (發表)	section 5
Work (實施)	section 6(4)

### 3. Meaning of “application for a standard patent”

In this Ordinance, unless the context otherwise requires, reference to an application for a standard patent is a reference to proceedings under Part II—

(a) under sections 15 to 22 to record a designated patent application; and

(b) under sections 23 to 27 for the registration of a designated patent and the grant of a standard patent for the invention shown in the published specification of the designated patent,

up to but not including the grant of the standard patent, and cognate expressions shall be construed accordingly; and reference to—

(i) the filing of an application for a standard patent is a reference to the filing of a request to record;

(ii) the date of filing an application for a standard patent is a reference to the date of filing a request to record;

(iii) an application for a standard patent as filed is a reference to a request to record as filed;

(iv) the publication of an application for a standard patent is a reference to the publication of a request to record;

(v) an invention which is the subject of an application for a standard patent, or an invention in respect of which an application for a standard patent has been made, is a reference to the invention disclosed in the specification of the corresponding designated patent or, if no request for registration and grant has been filed in the application, of the designated patent application;

(vi) the specification of an application for a standard patent is a reference to the specification of the corresponding designated patent application.

### 4. Meaning of “designated patent”, etc.

(1) In this Ordinance, unless the context otherwise requires—

“designated patent” (指定專利) means a patent granted by a designated patent office;

“designated patent application” (指定專利申請) means—

- (a) an application in a designated patent office for a patent, which application has been published under the law of the designated patent office;
- (b) an international application which has been published and which has validly entered its national phase in a designated patent office;

“designated patent office” (指定專利當局) means a patent office designated for the purpose of this Ordinance under section 8.

(2) In this Ordinance, unless the context otherwise requires, a reference—

- (a) to a “corresponding designated patent” in relation to a standard patent, is a reference to the designated patent which was registered under section 27 in an application for the grant of the standard patent;
- (b) to a “corresponding designated patent application”—
  - (i) in relation to an application for a standard patent for an invention, is a reference to the designated patent application in respect of that invention;
  - (ii) in relation to a standard patent, is a reference to the designated patent application in pursuance of which the corresponding designated patent was granted.

## 5. Meaning of “published”

(1) In this Ordinance, unless the context otherwise requires—

- (a) “published” (發表) means made available to the public (whether in Hong Kong or elsewhere); and
- (b) a document shall be taken to be published under any provision of this Ordinance if it can be inspected as of right at any place in Hong Kong by members of the public, whether on payment of a fee or not.

(2) Without prejudice to subsection (1), and unless the context otherwise requires, a reference in this Ordinance—

- (a) to the grant of a standard patent being published is a reference to its being published under section 27;
- (b) to a request to record being published is a reference to its being published under section 20;
- (c) to a designated patent being published is a reference to its being published by the designated patent office by which the patent was granted for the purposes of the law of that office relating to applications for and the granting of patents;

- (d) to a designated patent application being published is a reference—
- (i) except as provided in subparagraph (ii), to its being published by the designated patent office in which the application was made;
  - (ii) in the case of a designated patent application based on an international application, to the international application being published by the International Bureau under the Patent Cooperation Treaty, or by the designated patent office in which the application was made, whichever is the earlier;
- (e) to a short-term patent being published is a reference to its being published under section 118.

## 6. Other references

(1) Unless the context otherwise requires, a reference in this Ordinance to a patent is a reference to a standard patent or a short-term patent granted under this Ordinance.

(2) Unless the context otherwise requires, a reference in this Ordinance to an international agreement is a reference to—

- (a) the agreement, or any other international agreement replacing it, as may from time to time be amended or supplemented by or in accordance with any international agreement (including any protocol or annex);
- (b) any instrument made under any such agreement to provide for amendment to or supplementation of the agreement.

(3) Unless the context otherwise requires, a reference in this Ordinance to an enactment or law of a country, territory or area other than Hong Kong shall be construed as a reference to that enactment or law as it may from time to time be amended or extended by or under any other enactment or law of the country, territory or area.

(4) Unless the context otherwise requires, a reference in this Ordinance to an invention being worked in Hong Kong includes a reference to the invention being worked by importation into Hong Kong for the purpose of putting the patented product on the market or stocking it for that purpose.

(5) For the purposes of this Ordinance matter shall be taken to have been disclosed in any designated patent application or in the specification of a patent or a designated patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in any such application or specification.

[*cf.* 1977 c. 37 s. 130(3) U.K.]



## **7. Provisions regarding filing of documents, etc.**

In this Ordinance, unless the context otherwise requires, a reference providing for the filing of any document with the Registrar shall be deemed to include a reference requiring the payment of any fee that may be prescribed for the filing of that document, and a document shall be deemed not to be duly filed for the purposes of this Ordinance unless any such fee as may be prescribed for the filing of the document is paid as so prescribed.

## **8. Designation of patent offices**

The Governor in Council may for the purposes of this Ordinance by notice published in the Gazette designate a patent office established under the law of any country, territory or area other than Hong Kong or established under any international agreement.

## **9. Special provision regarding invention covered by 2 or more patents**

Where there are in effect 2 or more patents for the same invention, any use of the invention which does not constitute an infringement of any one such patent (whether by virtue of consent given by the proprietor, a compulsory licence having effect under Part VIII or the provisions of Part IX relating to Government use) shall not constitute an infringement of the other such patent.

# **PART II**

## **APPLICATIONS FOR STANDARD PATENTS**

### **Introduction**

## **10. General provision regarding applications for standard patents**

This Part shall be construed as providing for the grant of a standard patent for an invention in the following circumstances, and only in those circumstances, namely where—

- (a) an application for a patent for that invention has been filed in and published by a designated patent office (and in this Ordinance a patent application so filed and published is referred to as a “designated patent application”);

- (b) as the first stage of an application for a standard patent, the designated patent application has been recorded in the register and published in Hong Kong in accordance with sections 15 to 22;
- (c) a patent has been granted in the designated patent office in pursuance of the designated patent application (and in this Ordinance such a patent is referred to as a “designated patent”); and
- (d) as the second stage of the application for a standard patent, the designated patent has been registered in accordance with sections 23 to 27.

### **11. Formality examination of applications for standard patent**

Except as expressly provided to the contrary, nothing in this Part providing for the examination by the Registrar of an application for a standard patent for an invention shall be construed as imposing upon the Registrar any obligation to consider or to have regard to, for the purpose of such examination, any question as to—

- (a) the patentability of the invention;
- (b) whether the applicant is entitled to any priority claimed in the application;
- (c) whether the invention is properly disclosed in the application; or
- (d) whether any requirement under sections 45, 77, 78, 79, 93, 94, 95, 96, 97, 98, 99 or 100 has been complied with.

### **Right to apply**

### **12. Who may apply**

(1) The person who may apply for the grant of a standard patent for an invention is—

- (a) the person named as applicant in a designated patent application for a patent for the invention, or his successor in title to the rights under the designated patent application in Hong Kong; or
- (b) in preference to the person mentioned in paragraph (a), the person who is entitled to the property in the invention in Hong Kong.

(2) Subject to any determination under section 13, the applicant for a standard patent for an invention in proceedings before the Registrar shall for the purpose of those proceedings be deemed to be the person entitled to apply for the grant of a patent for that invention under subsection (1).

[*cf.* 1977 c. 37 s. 7 U.K.]

### 13. Determination before grant of questions as to who may apply

(1) At any time before a standard patent has been granted for an invention (whether or not an application has been made for a standard patent for the invention)—

- (a) any person may refer to the Registrar or the court the question of whether he is entitled under section 12 (alone or with other persons) to apply for the grant of a standard patent for the invention; or
- (b) any of 2 or more joint proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person.

(2) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under this section.

(3) Where a question is referred to the Registrar or the court under this section after an application for a standard patent has been filed but before a standard patent is granted in pursuance of the application then the Registrar or the court may, unless the application is withdrawn before the reference is disposed of by the Registrar or the court—

- (a) order that the application for a standard patent shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;
- (b) where the reference was made by 2 or more persons, order that the application shall proceed in all their names jointly; or
- (c) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.

(4) Where a person refers a question under subsection (1)(b) relating to an application, any order under subsection (2) may contain directions to any person for transferring or granting any right in or under the application.

(5) If any person to whom directions have been given under subsection (3)(c) or (4) fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the Registrar or the court may on application made to him or it by any person in whose favour or on whose reference the directions were given authorize him to do that thing on behalf of the person to whom the directions were given.

(6) No order shall be made under subsection (3) unless notice of such reference is given in the prescribed manner to—

- (a) the applicant for the standard patent (not being a party to the reference); or

- (b) any other person (not being a party to the reference) who it is alleged in the reference has the right, by virtue of any transaction, instrument or event relating to the invention or the application, to apply for the grant of the standard patent whether alone or with any other person,

and any person receiving such notice may oppose the reference.

(7) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

[*cf.* 1977 c. 37 s. 8 U.K.]

#### 14. Effect of transfer of application under section 13

(1) Where an order is made or directions are given under section 13 that an application for a standard patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the order and any directions under that section, continue in force and be treated as granted by the persons in whose name the application is to proceed.

(2) Where an order is made or directions are given under section 13 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to apply under section 12 for the grant of the patent), any licences or other rights in or under the application for a standard patent shall, subject to the order and any directions under that section and subject to subsection (3), lapse on the registration of that person or those persons as the applicant or applicants or, where the application for a standard patent has not been published, on the making of the order.

(3) If before a reference to the Registrar or the court under section 13 resulting in the making of any order mentioned in subsection (2)—

- (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in Hong Kong or made effective and serious preparations to do so; or
- (b) a licensee of the applicant, acting in good faith, worked the invention in Hong Kong or made effective and serious preparations to do so,

that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) Where an order is made as mentioned in subsection (2), the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence may refer to the Registrar or the court the question whether the latter is so entitled and whether any such period or terms are reasonable, and the Registrar or the court, as appropriate, shall determine the question and may, if he or it considers it appropriate, order the grant of such a licence.

(6) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under subsection (5).

[*cf. 1977 c. 37 s. 11 U.K.*]

### **Request to record a designated patent application**

#### **15. Filing of request to record**

(1) A person entitled under section 12(1) to apply for the grant of a standard patent for an invention may, at any time within 6 months after the date of publication of an application in a designated patent office for a patent for the invention, request the Registrar to enter a record of that designated patent application in the register (in this Ordinance referred to as a "request to record").

(2) Every such request shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain—

- (a) a photocopy of the designated patent application as published, that is to say, including any description, claims, drawings, search report or abstract published together with the designated patent application;
- (b) where the designated patent application does not contain the name of any person as being the inventor, a statement identifying the person or persons whom the applicant believes to be the inventor or inventors;
- (c) the name and address of the person making the request;
- (d) where the person filing the request is a person other than the person named as applicant in the designated patent application, a statement explaining his entitlement to apply for the grant of a standard patent for the invention and prescribed documents supporting that statement;
- (e) a statement indicating whether or not priority is claimed under section 98 in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application as mentioned in that section and, where the statement indicates that priority is so claimed, details of—

- (i) the date of priority claimed;
  - (ii) the country in which the earlier application was filed;
- (f) a statement indicating whether or not at the time of filing the designated patent application a claim was made in accordance with the law of the designated patent office in respect of any previous disclosure of the invention that was, for the purposes of the law of the designated patent office, a non-prejudicial disclosure and, if the statement indicates that such a claim was made, prescribed details relating to such previous disclosure; and
- (g) an address in Hong Kong for service of documents.

(3) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.

(4) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the request to record, and if either fee is not paid within that period or within such further period as may be allowed under subsection (5) the application for a standard patent shall be deemed to be withdrawn.

(5) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (4) may still be validly paid.

(6) Subsection (1) shall not apply in respect of a designated patent application published before the date on which the designated patent office was designated under section 8.

(7) Nothing in this section shall preclude a request to record being initiated by documents complying with section 17.

[*cf. EPC Art. 78; 1977 c. 37 s. 14 U.K.*]

## **16. Designated patent application based on international application**

Where a designated patent application is the national phase of an international application under the Patent Cooperation Treaty, then—

(a) for the purposes of section 15(1), and notwithstanding section 5(2)(d)(ii), the date of publication of the designated patent application shall be—

- (i) the date of such publication in the designated patent office as serves to indicate that the international application has validly entered its national phase in the designated patent office; or
- (ii) such other date as may be prescribed in rules, being a date not earlier than the date on which the international application has validly entered its national phase in the designated patent office;

- (b) reference in section 15(2)(a) to a photocopy of the designated patent application shall be read as reference to—
  - (i) a photocopy of the international application as published by the International Bureau;
  - (ii) a photocopy of any translation of the international application published by the designated patent office; and
  - (iii) a photocopy of any publication of information in the designated patent office concerning the international application;
- (c) the statement required for the purposes of section 15(2)(e) shall be a statement indicating whether or not priority is claimed under section 98, and if claimed whether so claimed on the basis of a right of priority claimed in the designated patent office, or claimed in the international application and accepted in the designated patent office, and mentioned in the corresponding designated patent application;
- (d) section 17(1)(c) shall have effect in such manner as may be specified in rules made for the purposes of this section.

#### **17. Date of filing of request to record**

(1) Subject to subsection (2) and section 18(3), the date of filing a request to record shall be the earliest date on which documents filed by the applicant contain—

- (a) an indication that a request is made to record a designated patent application;
- (b) information identifying the applicant; and
- (c) a reference to the designated patent application, including—
  - (i) the application number assigned to it by the designated patent office; and
  - (ii) the publication number assigned to it by the designated patent office, and the date of its publication by the designated patent office.

(2) If the earliest filing with the Registrar of any part of a request to record occurs more than 6 months after the publication of the corresponding designated patent application the request shall not be dealt with as an application for a standard patent.

[*cf. EPC Art. 80*]

#### **18. Examination on filing of request to record**

- (1) The Registrar shall examine whether —

- (a) the request to record satisfies the requirements of section 17(1) for the accordance of a date of filing (the “minimum requirements”);
  - (b) the filing fee and advertisement fee have been paid in due time.
- (2) Subject to section 17(2), if a date of filing cannot be accorded because of deficiencies as regards the minimum requirements, the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.
- (3) If such deficiencies are not corrected within the prescribed time, the request shall not be dealt with as an application for a standard patent.  
[*cf. EPC Art. 90*]

### **19. Examination as to formal requirements of request to record**

- (1) If a request to record has been accorded a date of filing and is not deemed to be withdrawn by virtue of section 15(4), the Registrar shall examine whether the requirements of section 15(2) and (3) (“the formal requirements”) have been satisfied.
- (2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be corrected, he shall give the applicant an opportunity to correct them in accordance with the rules.
- (3) If—
- (a) there are deficiencies as regards the formal requirements which cannot be corrected the application for a standard patent shall be refused;
  - (b) any deficiencies as regards the formal requirements noted in the examination are not corrected in accordance with the rules then, except as provided in subsection (4), the application for a standard patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.
- (4) If a deficiency relating solely to a claim to any right of priority is not duly corrected, such right shall be lost for the application.  
[*cf. EPC Art. 91*]

### **20. Publication of request to record**

- (1) If on an examination under section 19(1) a request to record is found to have satisfied the requirements of section 15(2) and (3), or if on a subsequent examination by the Registrar the deficiencies noted under section 19(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to this section and section 37---



- (a) record the designated patent application in the register and enter particulars of the request to record in the register;
  - (b) publish the request to record in the prescribed manner;
  - (c) advertise the fact of such publication and entry by notice in the Gazette;
  - (d) inform the applicant of the publication of the request to record.
- (2) A request to record shall not be published if—
- (a) before the completion of preparations for publication, it has been finally refused or withdrawn or has been deemed to have been withdrawn; or
  - (b) the filing fee or advertisement fee has not been paid.
- (3) For the purposes of subsection (1)(b) the request to record shall include—
- (a) the designated patent application, including the description, the claims, any drawings and any search report or abstract published by the designated patent office and filed in the request to record;
  - (b) the names of the proprietor and (if different) the inventor.

## 21. Registrar may publish additional matters

In publishing a request to record under section 20(1)(b), the Registrar may publish such matters constituting or relating to the request which in the Registrar's opinion it is desirable to publish in addition to the matters specified in section 20(3).

## 22. Provision for request to record in the event of a divisional designated patent application

- (1) Where in an application for a standard patent—
- (a) a request to record has been published under section 20 and has not been refused, withdrawn or deemed to be withdrawn; and
  - (b) the applicant for the corresponding designated patent application or his successor in title has filed in the designated patent office a divisional patent application ("a divisional corresponding designated patent application"), that is to say, an application for a patent which—
    - (i) is in respect of the same subject-matter and does not extend beyond the contents of the corresponding designated patent application as filed in the designated patent office;
    - (ii) has as its date of filing the date of filing of the corresponding designated patent application; and

(iii) enjoys the same benefit of any right of priority as the corresponding designated patent application, the applicant may within 6 months after the date of publication of the divisional designated patent application or publication of the request to record under this Ordinance, whichever is the later, request the Registrar to enter a record of that divisional designated patent application in the register.

(2) Where a request to record a divisional designated patent application is filed under this section—

- (a) it shall be deemed to have been filed on the date of filing of the earlier request to record and the application for a standard patent shall have the benefit of any right of priority;
- (b) subject to paragraph (a), the provisions of this Ordinance shall apply to such a request as they apply to a request to record filed under section 15(1).

(3) For the purpose of the application of the other provisions of this Ordinance to this section—

- (a) any reference in those other provisions to a corresponding designated patent application shall be read as a reference to the divisional designated patent application mentioned in subsection (1)(b);
- (b) any reference in those other provisions to a corresponding designated patent shall be read as a reference to the designated patent granted in pursuance of the divisional designated patent application.

[*cf. EPC Art. 76; 1992 No. 1 s. 24 Eire; 1977 c. 37 s. 15 U.K.*]

### **Request for registration and grant**

#### **23. Filing of request for registration and grant**

(1) Where in an application for a standard patent—

- (a) a designated patent application has been recorded in the register and a request to record has been published and the request to record is not refused or deemed withdrawn or abandoned (whether under this Part or Part III); and
- (b) a patent has been granted in the designated patent office in pursuance of the designated patent application,

the applicant or his successor in title may, subject to subsection (2), request the Registrar to register the designated patent so granted and to grant a standard patent for the invention shown in the published specification of the designated patent (in this Ordinance referred to as a “request for registration and grant”).

(2) A request for registration and grant under subsection (1) shall be made within 6 months after the date of grant of the designated patent by the designated patent office or publication of the request to record, whichever is the later.

(3) Every such request shall be filed with the Registrar in the prescribed manner and shall contain---

- (a) a verified copy of the published specification of the designated patent, including the description, the claims and any drawings published by the designated patent office;
- (b) if the person filing the request is a person other than the person named in the register as the applicant for a standard patent for the invention, a statement explaining the first-mentioned person's entitlement to apply for the grant of a standard patent for the invention and prescribed documents supporting that statement;
- (c) where the request to record contains a statement under section 15(2)(e) to the effect that priority is claimed on the basis of a right of priority claimed in the designated patent office, such copies as may be prescribed of the documents filed in the designated patent office claiming and supporting such right of priority.

(4) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.

(5) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing of a part of the request for registration and grant, and if either fee is not paid within that period or within such further period as may be allowed under subsection (6) the application for a patent shall be deemed to be withdrawn.

(6) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (5) may still be validly paid.

(7) Nothing in this section shall preclude a request for registration and grant being initiated in accordance with section 24.

#### **24. Date of filing request for registration and grant**

(1) Subject to subsection (2) and section 25(3), the date of filing of a request for registration and grant shall be the earliest date on which documents filed by the applicant contain---

- (a) an indication that a request is made for the registration of a designated patent and the grant of a standard patent;

- (b) information identifying the applicant;
- (c) the publication number assigned to the designated patent by the designated patent office, and the date of its publication; and
- (d) the publication number assigned to the request to record by the Registrar.

(2) If the earliest filing with the Registrar of any part of a request for registration and grant occurred more than 6 months after the later of—

- (a) the date of grant of the designated patent; and
- (b) publication of the request to record in accordance with section 20,

then the application shall be deemed to be withdrawn.

## **25. Examination on filing of request for registration and grant**

(1) The Registrar shall examine whether—

- (a) the request for registration and grant satisfies the requirements of section 24(1) for the accordance of a date of filing; and
- (b) the filing fee and advertisement fee have been paid in due time.

(2) Subject to section 24(2), if on examination under subsection (1)(a) a date of filing cannot be accorded because of deficiencies as regards the requirements mentioned in subsection (1)(a), the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.

(3) If—

- (a) there are deficiencies as regards the requirements specified in section 24(1) which cannot be corrected the application for a standard patent shall be refused;
- (b) any deficiencies as regards those requirements noted in the examination under subsection (1) are not corrected in accordance with the rules, the application for a standard patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.

## **26. Examination as to formal requirements of the request for registration and grant**

(1) If a request for registration and grant has been accorded a date of filing and is not deemed to be withdrawn by virtue of section 23(5), the Registrar shall examine whether the requirements of section 23(3) and (4) (“the formal requirements”) have been satisfied.

(2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be corrected, he shall give the applicant an opportunity to correct them in accordance with the rules.

(3) If—

(a) there are deficiencies as regards the formal requirements which cannot be corrected the application for a standard patent shall be refused;

(b) any deficiencies as regards the formal requirements noted in the examination are not corrected in accordance with the rules then, except as provided in subsection (4), the application for a standard patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.

(4) If a deficiency relating solely to a claim to any right of priority is not duly corrected then such right shall be lost for the application.

[*cf. EPC Art. 91*]

## **27. Registration of designated patent and grant of patent**

(1) If on examination under section 26(1) a request for registration and grant is found to have satisfied the requirements of section 23(3) and (4) or if on a subsequent examination the deficiencies noted under section 26(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to section 37—

(a) register the designated patent by making an appropriate entry in the register; and

(b) grant a standard patent for the invention shown in the published specification of the designated patent as filed under section 23(3)(a) and issue a certificate to that effect.

(2) A patent shall not be granted under this section unless the filing fee and advertisement fee specified in section 23 and any other fees payable under the preceding provisions of this Part have been paid.

(3) As soon as practicable after a standard patent has been granted under this section the Registrar shall—

(a) publish in the prescribed manner the specification of the patent, the names of the proprietor and, if different, the inventor;

(b) send the certificate issued under subsection (1)(b) to the proprietor; and

(c) advertise the fact of such grant by notice in the Gazette.

(4) In publishing under subsection (3)(a) any matters specified in that subsection, the Registrar may publish in addition such other matters constituting or relating to the patent which in his opinion it is desirable to publish.

## Further processing; restoration of rights

### 28. Further processing of application for standard patent

(1) Subject to this section, where—

- (a) an application for a standard patent, or any part of an application, is refused or is deemed withdrawn following the applicant's failure to comply with a time limit under this Part (including any time limit set by the Registrar); and
- (b) the applicant has by notice filed with the Registrar requested reinstatement of the application or part of the application,

then the legal consequence of the failure to comply with the time limit, as provided under the Ordinance, shall not ensue or, if it has already ensued, shall be retracted.

(2) A notice under this section—

- (a) shall be in writing and shall be filed within 2 months after such refusal or deemed withdrawal;
- (b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and
- (c) shall not be deemed to be filed unless the omission which constituted the failure to comply with a time limit has been made good.

(3) This section does not apply in the case of the refusal or deemed withdrawal of an application under section 15(4), 23(5), 24(2) or 25(3).

(4) The Registrar may by regulation amend the period specified in subsection (2)(a) within which a notice under this section shall be filed.

[*cf. EPC Art. 121*]

### 29. Restoration of rights

(1) Subject to this section, where—

- (a) an applicant for a standard patent has failed to comply with a time limit under this Part (including any time limit set by the Registrar); and
- (b) the Registrar is satisfied that the failure to comply with the time limit occurred in spite of the applicant having taken all reasonable care required by the circumstances,

then upon application by the applicant to the Registrar under this section for restoration of his rights lost—

- (i) any refusal or deemed withdrawal of the application that occurred as a direct consequence of the failure to comply with the time limit shall be deemed to be of no effect and the application shall be treated for the purposes of proceedings under this Part as if there had been no such failure;
  - (ii) any right or means of redress lost by the applicant as a direct consequence of the failure to comply with the time limit shall be restored to the applicant.
- (2) An application under this section—
- (a) shall be in writing and shall be made not later than—
    - (i) 1 year after the expiry of the time limit referred to in subsection (1)(a); or
    - (ii) 2 months after the removal of the cause of non-compliance with the time limit,whichever is the earlier;
  - (b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and
  - (c) shall not be deemed to be made unless the omission which constituted the failure to comply with a time limit has been made good.

(3) Where prior to the refusal or deemed withdrawal of the application mentioned in subsection (1)(i) the request to record had been published under section 20, the Registrar shall advertise in the Gazette notice of any application under subsection (1).

(4) The Registrar may by regulation amend the periods specified in subsection (2)(a) within which a notice under this section shall be filed.

(5) This section does not apply to any failure to comply with a time limit under section 15 (except as regards any time limit specified for the purposes of section 15(3)), 17(2), 18, 19, 22, 23(5), 24(2) or 25(3).

[*cf. EPC Art. 122*]

### **30. Effect of restoration of rights under section 29**

(1) The effect of a restoration under section 29 is as follows.

(2) A person who, during the period between the loss of rights referred to in section 29(1) and the advertisement in the Gazette of notice of the application for restoration under section 29(3)—

- (a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a standard patent if those rights had not been lost; or
- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (3).

(3) The rights referred to in subsection (2) are—

(a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);

(b) if such act was done or preparations had been made to do it in the course of a business—

(i) in the case of an individual—

(A) the right to assign the right to do it or to transmit such right on death; or

(B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a patent concerned.

(4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).

(5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the patent application.

*[cf. 1992 No. 1 s. 55(2) to (4) Eire]*

### PART III

#### PROVISIONS AS TO APPLICATIONS FOR STANDARD PATENTS BEFORE GRANT

#### 31. Amendment of application for standard patent

(1) Subject to this section and sections 36 and 103, an applicant for a standard patent may at any time before a standard patent is granted pursuant to the application, in accordance with the prescribed conditions, amend the application of his own volition.

(2) No amendment may be made under subsection (1) to the title of the invention, the abstract, a priority claim or any claim, description or drawing unless—



- (a) the application has been published; and
  - (b) the amendment is an amendment that has been made to the corresponding designated patent application.
- (3) Upon receipt of particulars of an amendment filed in accordance with subsections (1) and (2) the Registrar shall record the amendment.

### **32. Withdrawal of application**

(1) Subject to section 36, an applicant for a standard patent may at any time before a standard patent is granted pursuant to the application withdraw in writing his application and any such withdrawal may not be revoked.

(2) Where a patent application is withdrawn under this section, or is deemed under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, then—

- (a) if the application has been published, section 94(3) shall continue to apply as regards the application;
- (b) the applicant shall continue to enjoy the right of priority under section 98 which he enjoyed immediately before such withdrawal or refusal;
- (c) no other right may be claimed under this Ordinance in relation to the application.

### **33. Maintaining application for standard patent**

(1) This section applies to an application for a standard patent which has been published but in which no request has been made for registration and grant under section 23.

(2) If it is desired to maintain a patent application to which this section applies for a further year after the expiry of the 5th or any succeeding year from the date specified in subsection (3), the applicant shall, before the expiry of that 5th or succeeding year (as the case may be), but not earlier than a date 3 months before that expiry, apply to the Registrar in the prescribed manner for the maintenance of the patent application (“maintenance application”) and pay the prescribed fee (“maintenance fee”) and a patent application to which this section applies shall be deemed to be withdrawn and abandoned at the expiry of that 5th or succeeding year if the maintenance application is not so made or the maintenance fee is not so paid.

(3) The date specified for the purpose of subsection (2) is the anniversary of the date of filing the corresponding designated patent application first occurring after the date of publishing the request to record.

(4) If, within 6 months after the end of the period specified in subsection (2) for the making of a maintenance application, an application is made under subsection (2) and the maintenance fee and any prescribed additional fee are paid in the prescribed manner then the patent application shall be treated as if it had not been withdrawn or abandoned.

(5) If statements contained in the maintenance application indicate—

(a) that as at a date specified in the application, being a date not earlier than 1 month before the date of making the application—

(i) the designated patent application has not been withdrawn or abandoned for the purposes of the law of the designated patent office; and

(ii) there has been no final refusal by the designated patent office to grant a patent pursuant to the designated patent application; and

(b) that—

(i) as at the date specified for the purposes of paragraph (a) a patent had not been granted pursuant to the designated patent application; or

(ii) a patent has been granted pursuant to the designated patent application, and the date of such grant is a date within 6 months before the date of the application,

the Registrar shall, subject to subsection (9), maintain the application for a patent.

(6) Where a statement contained in a maintenance application indicates that a designated patent has been granted on a date within the 6 months before the date of the maintenance application, any maintenance of the patent application by virtue of subsection (5) shall have effect for a term ending 6 months after the date of such grant.

(7) If there are deficiencies in the maintenance application that may be corrected the Registrar shall give the applicant an opportunity to correct them in accordance with the rules.

(8) If the Registrar is not satisfied as to the veracity of a statement in the maintenance application, he shall notify the applicant accordingly giving reasons and shall allow the applicant an opportunity to make further statements or adduce material for the purpose of so satisfying him.

(9) If in an application under this section—

(a) statements contained in the application indicate that—

(i) the designated patent application has been withdrawn or abandoned pursuant to the law of the designated patent office;

(ii) the designated patent office has finally refused the grant of a patent in pursuance of the designated patent application;  
or

- (iii) a designated patent has been granted in pursuance of the designated patent application, and the date of such grant was a date more than 6 months before the date of the application;
- (b) deficiencies as noted by the Registrar are not corrected in accordance with the rules; or
- (c) the applicant has failed to satisfy the Registrar as to the veracity of a statement in respect of which notice has been given under subsection (8),

the Registrar shall refuse to maintain the application for a patent and upon such refusal that application shall be deemed to be withdrawn or abandoned.

(10) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the earliest date for making a maintenance application under that subsection is determined.

(11) The Governor in Council may by regulation amend the period specified in subsection (2) as being the period after which a standard patent application not maintained shall be deemed to be withdrawn and abandoned.

[*cf. EPC Art. 86*]

### 34. Restoring application for standard patent

(1) Where an application for a standard patent is deemed withdrawn under section 33 by reason only of the failure to pay any maintenance fee under that section within the period specified then the applicant may, within 12 months after the date on which the application was deemed withdrawn and on payment of the prescribed fee, apply to the Registrar in the prescribed manner for the restoration of the application for a standard patent.

(2) The Registrar shall advertise in the Gazette notice of any application under subsection (1).

(3) If on an application under subsection (1)—

- (a) the Registrar is satisfied that the failure to pay the maintenance fee within the specified period, or that fee and any additional fee under section 33(4) within 6 months after the end of the specified period, occurred in spite of the applicant having taken all reasonable care required by the circumstances; and

(b) the requirements of subsection (4) are met,

the Registrar shall order that the request to record be restored on payment of any such unpaid maintenance fee and additional fee.

(4) An order for restoration shall not be made under subsection (3) unless it appears to the Registrar that at the date of the application for restoration—

- (a) the designated patent application is still valid and not withdrawn; and
- (b) a patent has not been granted in pursuance of that application or, if granted, the time for filing a request for registration and grant under section 23 has not expired.

[*cf. EPC Art. 122*]

### 35. Effect of restoration order under section 34

(1) The effect of a restoration under section 34(4) is as follows.

(2) A person who, during the period between any deemed withdrawal such as is mentioned in section 34(1) and the advertisement in the Gazette of notice of the application for restoration under section 34(2)—

- (a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a patent if those rights had not been lost; or
- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (3).

(3) The rights referred to in subsection (2) are—

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);
- (b) if such act was done or preparations had been made to do it in the course of a business—
  - (i) in the case of an individual—
    - (A) the right to assign the right to do it or to transmit such right on death; or
    - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution, and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a patent concerned.

(4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).

(5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the patent application.

(6) This section applies in relation to the Government use of an invention in respect of which an application has been made as it applies in relation to infringement of the rights conferred by publication of an application for a standard patent for the invention.

[*cf.* 1992 No. 1 s. 55(2) to (4) *Eire*]

### **36. Limitation on withdrawal, amendment, etc. of application**

No withdrawal of an application under section 32, no request to enter a record of a divisional application under section 22(1) nor any amendment under section 31 shall be allowed after the date on which preparations for publication under section 27(3) of the specification of a standard patent to be granted in pursuance of the application have been completed.

### **37. Registrar may refuse to record under section 20 or to register and grant under section 27**

(1) The Registrar may refuse to record a designated patent application under section 20(1) or to register a designated patent under section 27 if he considers that the invention the subject of the application for the standard patent is not a patentable invention by reason of any of the matters specified in section 93(5).

(2) The Registrar shall give notice in writing to the applicant of any such refusal.

## **PART IV**

### **PROVISIONS AS TO PATENTS AFTER GRANT**

#### **Standard patents**

### **38. Deemed date of filing where standard patent has been granted**

Where a standard patent is granted, the application for the standard patent shall be deemed to have as its date of filing the date of filing of the corresponding designated patent application, and in this Ordinance "deemed date of filing" (當作提交日期) in relation to an application for a standard patent shall be construed accordingly.

### 39. Term of standard patent

(1) A standard patent granted under this Ordinance—

- (a) shall take effect from the date on which the fact of its grant is advertised in the Gazette; and
- (b) subject to subsection (2), shall remain in force until the end of the period of 20 years beginning with the deemed date of filing of the application for the patent.

(2) If it is desired to keep a standard patent in force for a further year after the expiry of the 3rd or any succeeding year from the date specified in subsection (3), the prescribed renewal fee shall be paid before the expiry of that 3rd or, as the case may be, succeeding year, but not earlier than a date 3 months before that expiry, and a standard patent shall cease to have effect at the expiry of that 3rd or succeeding year if the renewal fee is not so paid.

(3) The date specified for the purpose of subsection (2) is the anniversary of the deemed date of filing of the standard patent first occurring after the date of grant of the patent.

(4) If within 6 months after the end of the period specified in subsection (2) for payment of the renewal fee the renewal fee and any prescribed additional fee are paid, the standard patent shall be treated as if it had never expired, and accordingly—

- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
- (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.

(5) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the earliest date for payment of the prescribed renewal fee is determined.

(6) The Governor in Council may by regulation amend—

- (a) the period specified in subsection (1)(b) as being the period for which a standard patent shall remain in force;
- (b) the period specified in subsection (2) by reference to which a standard patent, if not renewed, shall cease to have effect.

[*cf.* 1977 c. 37 s. 25 U.K.]

### 40. Restoration of lapsed standard patents

(1) Where a standard patent has ceased to have effect by reason of the failure to pay any renewal fee as provided in section 39, application may be made to the Registrar, at any time within 18 months after the date on which the patent ceased to have effect, for the restoration of the patent.

(2) An application under this section may be made by the person who was the proprietor of the standard patent at the time it ceased to have effect or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was at that time held by 2 or more persons jointly the application may, with the leave of the Registrar, be made by one or more of them without joining the others.

(3) The Registrar shall advertise in the Gazette notice of any application under this section.

(4) If the Registrar is satisfied that the failure to pay any renewal fee as provided in section 39, or to pay that fee and any additional fee under that section within 6 months after the end of that period, occurred in spite of the applicant having taken all reasonable care required by the circumstances the Registrar shall by order restore the patent on payment of any such unpaid renewal fee and any prescribed additional fee.

(5) An order under this section may be made subject to such terms and conditions as the Registrar thinks fit.

[*cf.* 1949 *c.* 87 *s.* 28 *U.K.*; 1977 *c.* 37 *s.* 28 *U.K.*; *EPC Art.* 122]

#### 41. Effect of order for restoration of standard patent

(1) The effect of an order for the restoration of a standard patent is as follows.

(2) Anything done during the period between expiry and restoration which would have constituted an infringement if the patent had not expired shall be treated as an infringement—

(a) if done at a time when it was possible for the patent to be renewed under section 39(4); or

(b) if it was a continuation or repetition of an earlier infringing act.

(3) A person who in Hong Kong, after it was no longer possible for the patent to be so renewed and before advertisement in the Gazette of notice of an application for restoration under section 40—

(a) began in good faith to do an act which would constitute an infringement of the patent if it were in force; or

(b) made in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (4).

(4) The rights referred to in subsection (3) are—

(a) the right to continue to do or, as the case may be, to do the act referred to in subsection (3);

(b) if such act was done or preparations had been made to do it in the course of a business—

(i) in the case of an individual—

- (A) the right to assign the right to do it or to transmit such right on death; or
- (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution, and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(5) The rights specified in subsection (4) shall not include the right to grant a licence to any person to do an act referred to in subsection (3).

(6) Where a patented product is disposed of to another in exercise of a right conferred by subsection (4), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by a registered proprietor of the patent.

*[cf. 1992 No. 1 s. 55(2) to (5) Eire]*

#### **42. Determination after grant of questions referred before grant**

(1) If a question with respect to a standard patent or application for a standard patent is referred by any person to the Registrar or the court under section 13, whether before or after the making of an application for the patent, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a standard patent, but on its grant that person shall be treated as having referred to the Registrar or the court under section 55 any question mentioned in that section which the Registrar or the court thinks appropriate.

(2) In determining any such question under section 55 the Registrar shall exercise only the powers that are available to him for the purposes of determining the same question referred to him under section 13.

*[cf. 1977 c. 37 s. 9 U.K.]*

#### **43. Amendment of standard patent following opposition or revocation proceedings in the designated patent office**

(1) If the specification of the corresponding designated patent in respect of a standard patent granted under Part II has (whether before or after the grant of the standard patent) been amended in the designated patent office following prescribed opposition or revocation proceedings, the proprietor of the standard patent shall file with the Registrar in the prescribed manner and within the prescribed period a verified copy of the amended specification or the amending order or other prescribed documentation.



(2) The Registrar shall record the amendment to the specification of the designated patent by making an appropriate entry in the register and upon that recording the standard patent shall be treated as having been amended in a like manner.

(3) As soon as practicable after a standard patent has been amended under this section the Registrar shall—

(a) publish the amendment;

(b) advertise the fact of the amendment by notice in the Gazette.

(4) Any amendment of the specification of a standard patent under this section shall have effect from the date of grant of the patent.

(5) Any amendment of the specification of a standard patent under this section shall have effect subject to section 103.

[*cf. EPC Art. 102*]

#### **44. Revocation of standard patent following opposition or revocation proceedings in the designated patent office**

(1) This section applies to any standard patent of which the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.

(2) The proprietor of a patent to which this section applies shall after publication of the revocation by the designated patent office and in the prescribed manner file with the Registrar a verified copy of the order of revocation or other prescribed documentation.

(3) The Registrar shall record any filing under subsection (2) and shall advertise the fact of such filing by notice in the Gazette.

(4) A person other than the proprietor of a patent to which this section applies may apply to the Registrar in the prescribed manner for an order under this subsection, and where on such an application the Registrar is satisfied that the patent is one to which this section applies he shall, subject to subsection (5), order that the patent be revoked.

(5) The Registrar may, if he thinks fit, refer any application under subsection (4) to the court and the court shall have jurisdiction to make an order for the revocation of the patent.

(6) Upon the Registrar advertising the fact of a filing by the proprietor of a patent under subsection (2) in the Gazette, or upon the making of an order by the Registrar under subsection (4) or by the court under subsection (5) for the revocation of a patent, the patent shall be treated as never having had effect.

[*cf. EPC Art. 102*]

## Patents generally

### 45. Mention of inventor

(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention.

(2) Where a person has been mentioned in a patent as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time after the grant of the patent request the Registrar to make a finding to that effect; and if the Registrar makes such a finding he shall accordingly amend the register and any undistributed copies of the patent, and may issue a certificate to the effect of his finding.

[*cf.* 1977 c. 37 s. 13 U.K.; 1992 No. 1 s. 17 Eire]

### 46. General power to amend specification after grant

(1) Subject to section 103, the proprietor of a patent granted under this Ordinance may apply to the court to amend the specification of the patent and the court may by order allow any such amendment subject to such conditions as it thinks fit.

(2) No such amendment shall be allowed if there are pending before the court proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect as from the grant of the patent.

(4) Any person wishing to oppose an application under this section may, in accordance with rules of court, give to the court notice of opposition; and the court shall consider the opposition in deciding whether to grant the application.

(5) Upon receipt of the court order and supporting documents filed in the prescribed manner the Registrar shall record the amendments to the specification of the patent and shall publish this and advertise the fact by notice in the Gazette.

(6) The Registrar may, without any application being made to the court or to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade mark.

(7) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

[*cf.* 1977 c. 37 s. 27 U.K.]

#### 47. Patent not to be impugned for lack of unity

No person may in any proceedings object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate—

- (a) to more than one invention; or
- (b) to a group of inventions which are not so linked as to form a single inventive concept.

[*cf.* 1977 c. 37 s. 26 U.K.]

#### 48. Surrender of patents

(1) The proprietor of a patent may at any time by written notice given to the Registrar offer to surrender his patent.

(2) Any person may give notice to the Registrar of his opposition to the surrender of a patent under this section, and if he does so the Registrar shall notify the proprietor of the patent and, subject to subsection (4), shall determine the question.

(3) If the Registrar is satisfied that the patent may properly be surrendered he may accept the offer and, as from the date on which notice of his acceptance is advertised in the Gazette, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any Government use of the patented invention before that date.

(4) The Registrar may if he thinks fit refer the matter to the court for determination.

[*cf.* 1977 c. 37 s. 29 U.K.]

#### 49. Registrar's power to revoke patent on grounds of "ordre public" or morality

(1) Any person may at any time after a patent has been granted for an invention under this Ordinance refer to the Registrar the question of whether, having regard to any of the matters specified in section 93(5), the invention is a patentable invention.

(2) Where a question is so referred—

- (a) subject to paragraph (b), the Registrar shall determine the question;
- (b) the Registrar may if he thinks fit refer the question to be determined by the court and, without prejudice to the court's jurisdiction apart from this paragraph to determine any such question, the court shall have jurisdiction to do so.

(3) If the Registrar or the court determines that the invention is not a patentable invention by reason of any of the matters specified in section 93(5) he or it shall order that the patent shall be revoked and upon the making of such an order the patent shall be treated as never having had effect.

(4) Any person may oppose a reference under subsection (2).

## PART V

### PROPERTY IN PATENTS AND APPLICATIONS; REGISTRATION

#### 50. Nature of, and transactions in, patents and applications for patents

(1) Any patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with subsections (2) to (7).

(2) Subject to section 54, any patent or any such application, or any right in it, may be assigned or mortgaged.

(3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(4) Subject to section 54, a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application; and—

(a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and

(b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(5) Subsections (2) to (4) shall have effect subject to this Ordinance.

(6) Any of the following transactions, that is to say—

(a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;

(b) any assent relating to any patent or any such application or right, shall be void unless it is in writing and is signed by or on behalf of the assignor, mortgagor or party granting such assent as the case may be (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) or in the case of a body corporate is so signed or is under the seal of that body.

(7) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 80 or 88 for a previous infringement or to bring proceedings under section 72 for a previous act.

[*cf.* 1977 c. 37 s. 30 U.K.]

## 51. Register of patents

(1) The Registrar shall keep a register to be known as the register of patents, which shall comply with rules made for the purposes of this section and shall be kept in accordance with such rules.

(2) Without prejudice to any other provision of this Ordinance—

(a) rules shall be made providing for the registration of—  
 (i) patents and of published applications for standard patents; and

(ii) transactions, instruments or events affecting rights in or under patents and published applications for standard patents;

(b) rules made for the purposes of this section may provide, in connection with rules made for the purposes of paragraph (a), for—

(i) the furnishing to the Registrar of any prescribed documents or description of documents in connection with any matter which is required to be registered;

(ii) the correction of errors in the register and in any documents filed with the Registrar in connection with registration; and

(iii) the publication and advertisement of anything done under this Ordinance in relation to the register; and

(c) rules made for the purposes of this section may provide for notification to the Registrar of any matter affecting the property in an application for a patent.

(3) Notwithstanding subsection (2)(a)(ii), no notice of any trust, whether express, implied or constructive, shall be entered in the register and the Registrar shall not be affected by any such notice.

(4) The register need not be kept in documentary form.

(5) Subject to any rules, the public shall have a right to inspect the register at the registry at all convenient times.

(6) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(7) Applications under subsection (6) or rules made by virtue of that subsection shall be made in such manner as may be prescribed.

(8) In relation to any portion of the register kept otherwise than in documentary form—

- (a) the right of inspection conferred by subsection (5) is a right to inspect the material on the register; and
- (b) the right to a copy or extract conferred by subsection (6) or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

(9) Subject to subsection (12), the register shall be prima facie evidence of anything required or authorized by this Ordinance to be registered.

(10) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorized by this Ordinance to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be prima facie evidence of the matters so certified.

(11) Each of the following, that is to say—

- (a) a copy of an entry in the register or an extract from the register which is supplied under subsection (6);
- (b) a copy of any document kept at the registry or an extract from any such document, any specification of a patent or any application for a standard patent which has been published,

which purports to be a certified copy or a certified extract shall, subject to subsection (12), be admitted in evidence without further proof and without production of any original.

(12) This section is without prejudice to section 22A, 22B, 50 or 51 of the Evidence Ordinance (Cap. 8) or any provision made by virtue of any of those sections.

(13) In this section “certified copy” (核證副本) and “certified extract” (核證摘錄) mean a copy and extract certified by the Registrar and sealed with the seal of the Registrar.

[*cf.* 1977 c. 37 s. 32 U.K.]

## 52. Effect of registration procedures on rights in patents

(1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event—

(a) either—

- (i) application has not been made for registration of the earlier transaction, instrument or event; or

- (ii) in the case of any application for a standard patent which has not been published or any application for a short-term patent, notice of the earlier transaction, instrument or event has not been given to the Registrar in accordance with rules (if any) made for the purposes of section 51(2)(c); and
- (b) the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event.

(2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

(3) This section applies to the following transactions, instruments and events—

- (a) the assignment of a patent or application for a patent, or a right in it;
- (b) the mortgage of a patent or application or the granting of security over it;
- (c) the grant or assignment of a licence or sub-licence or mortgage of a licence or sub-licence under a patent or application;
- (d) the death of the proprietor or one of the proprietors of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right; and
- (e) any order or directions of a court or other competent authority transferring a patent or application or any right in or under it to any person and the event by virtue of which the court or authority had power to make any such order or give any such directions.

[*cf.* 1977 c. 37 s. 33 U.K.]

### 53. Rectification of register

(1) The court may, on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it.

(2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

[*cf.* 1977 c. 37 s. 34 U.K.]

#### **54. Co-ownership of patents and applications for patents**

(1) Where a patent is granted to 2 or more persons each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Where 2 or more persons are proprietors of a patent, then, subject to this section and to any agreement to the contrary, each of them shall be entitled, by himself or his agent, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and sections 68 and 69 amount to an infringement of the patent concerned; and any such act shall not amount to an infringement of the patent concerned.

(3) Subject to sections 13 and 55 and to any agreement for the time being in force, where 2 or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent.

(4) Subject to those sections, where 2 or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.

(5) Where a patented product is disposed of by any of 2 or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) This section shall have effect in relation to an application for a patent as filed as it has effect in relation to a patent and—

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

(b) the reference in subsection (5) to a patented product shall be construed accordingly.

[*cf.* 1977 c. 37 s. 36 U.K.; EPC Art. 59]

#### **55. Determination of right to patent after grant**

(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the court the question---



- (a) who is or are the true proprietor or proprietors of the patent;
- (b) whether the patent should have been granted to the person or persons to whom it was granted; or
- (c) whether any right in or under the patent should be transferred or granted to any other person or persons,

and the court shall determine the question and make such order as it thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1), an order under that subsection may contain provision—

- (a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;
- (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
- (c) granting any licence or other right in or under the patent;
- (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.

(3) If any person to whom directions have been given under subsection (2)(d) fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the court may, on application made to it by any person in whose favour or on whose reference the order containing the directions was made, authorize him to do that thing on behalf of the person to whom the directions were given.

(4) Where the court finds on a reference under this section that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 91 makes an order on that ground for the conditional or unconditional revocation of the patent, the court may order that the person by whom the application was made or his successor in title may, subject to section 103, make a new application for a patent—

- (a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and
- (b) in the case of conditional revocation, for the matter which in the opinion of the court should be excluded from that specification by amendment under section 102.

(5) Where a new application for a patent is made under subsection (4), it shall be treated—

- (a) as having been filed on the date of filing the application to which the reference relates; and

- (b) as having the same date of filing and, where the reference under this section is in respect of a standard patent, as having the same deemed date of filing, as the application to which the reference relates.
- (6) Where the reference under this section is in respect of a standard patent, the court may order in respect of any new application under subsection (4)—
- (a) that all or any of the requirements of section 15(2) or (3) or 23(3) or (4) be dispensed with; and
  - (b) that the person making the new application shall for the purposes of that application be deemed to have filed a request to record having the same date of filing as the request to record in the application for the patent to which the reference relates.
- (7) On any such reference as is mentioned in subsection (4) no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) on that ground, if the reference was made after the end of 2 years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.
- (8) Where a question is referred to the court under this section an order shall not be made by virtue of subsection (2) or under subsection (4) on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent except those who are parties to the reference.

[*cf.* 1977 c. 37 s. 37 U.K.]

## **56. Effect of transfer of patent under section 55**

(1) Where an order is made under section 55 that a patent shall be transferred from any person or persons (the old proprietor or proprietors) to one or more persons (whether or not including an old proprietor), then, except in a case falling within subsection (2), any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 50 and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred (the new proprietor or proprietors).

(2) Where an order is so made that a patent shall be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor (on the ground that the patent was granted to a person not entitled to be granted the patent), any licences or other rights in or under the patent shall, subject to the provisions of the order and subsection (3), lapse on the registration of that person or those persons as the new proprietor or proprietors of the patent.

(3) Where an order is so made that a patent shall be transferred as mentioned in subsection (2) or that a person other than an old proprietor may make a new application for a patent and before the reference of the question under section 55 resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith, worked the invention in question in Hong Kong or made effective and serious preparations to do so, the old proprietor or proprietors or the licensee shall on making a request to the new proprietor or proprietors within the prescribed period be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention, so far as it is the subject of the new application.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) The new proprietor or proprietors of the patent or any person claiming that he is entitled to be granted any such licence may refer to the court the question whether that person is so entitled and whether any such period is or terms are reasonable, and the court shall determine the question and may, if it considers it appropriate, order the grant of such a licence.

[*cf.* 1977 c. 37 s. 38 U.K.]

## PART VI

### EMPLOYEES' INVENTIONS

#### 57. Right to employees' inventions

(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Ordinance and all other purposes if—

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent; or
- (b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any protected layout-design (topography) right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

[*cf.* 1977 c. 37 s. 39 U.K.]

## 58. Compensation of employees for certain inventions

(1) Where it appears to the court on an application made by an employee within the prescribed period that—

- (a) the employee has made an invention belonging to the employer for which a patent has been granted;
- (b) the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer; and
- (c) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer,

the court may award him such compensation of an amount determined under section 59.

(2) Where it appears to the court on an application made by an employee within the prescribed period that—

- (a) a patent has been granted for an invention made by and belonging to the employee;
- (b) his rights in the invention, or in any patent or application for a patent for the invention, have since the commencement of this section been assigned to the employer or an exclusive licence under the patent or application for a patent has since the commencement of this section been granted to the employer;
- (c) having regard to all the circumstances of the case, including the terms of the contract of assignment or grant or any ancillary contract ("the relevant contract"), the benefit derived by the employee from the relevant contract is inadequate in relation to the benefit derived by the employer from the patent; and
- (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract,

the court may award him such compensation of an amount determined under section 59.

(3) Subsection (2) shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention.

(4) References in this section to an invention belonging to an employer or an employee are references to it so belonging as between the employer and the employee.

[*cf.* 1977 c. 37 s. 40 U.K.]

## 59. Amount of compensation

(1) An award of compensation to an employee under section 58(1) or (2) in relation to a patent for an invention shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from—

- (a) the patent; or
- (b) the assignment or grant to a person connected with the employer of—
  - (i) the property or any right in the invention; or
  - (ii) the property in, or any right in or under, an application for that patent.

(2) For the purposes of subsection (1), the amount of any benefit derived or expected to be derived by an employer from the assignment or grant of—

- (a) the property in, or any such right in or under—
  - (i) a patent for the invention; or
  - (ii) an application for such a patent; or
- (b) the property or any right in the invention,

to a person connected with him shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him.

(3) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which has always belonged to an employer, the court shall, among other things, take the following matters into account, that is to say—

- (a) the nature of the employee's duties, his remuneration and the other advantages he derives or has derived from his employment or has derived in relation to the invention under this Ordinance;
- (b) the effort and skill which the employee has devoted to making the invention;
- (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and
- (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities.

(4) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which originally belonged to him, the court shall, among other things, take the following matters into account, that is to say—

- (a) any conditions in a licence or licences granted under this Ordinance or otherwise in respect of the invention or the patent;
- (b) the extent to which the invention was made jointly by the employee with any other person; and
- (c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (3)(d).

(5) Any order for the payment of compensation under section 58 may be an order for the payment of a lump sum or for periodical payment, or both.

(6) Without prejudice to section 39(1) of the Interpretation and General Clauses Ordinance (Cap. 1), the refusal of the court to make any such order on an application made by an employee under section 58 shall not prevent a further application being made under that section by him or any successor in title of his.

(7) Where the court has made any such order, the court may on the application of either the employer or the employee vary or discharge it or suspend any provision of the order and revive any provision so suspended.

[*cf.* 1977 c. 37 s. 41 U.K.]

#### **60. Enforceability of contracts relating to employees' inventions**

(1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by him—

- (a) with the employer (alone or with another); or
- (b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.

(2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the commencement of this section and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.

(3) Subsection (2) is without prejudice to any duty of confidentiality owed to his employer by an employee by virtue of any rule of law or otherwise.

(4) This section applies to any arrangement made with a public officer in the course of his duties as it applies to any contract made between an employee and an employer other than the Government.

[*cf.* 1977 c. 37 s. 42 U.K.]

## 61. Supplementary

(1) Sections 57 to 60 shall not apply to an invention made before the commencement of this Ordinance.

(2) Sections 57 to 60 shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say—

- (a) he was mainly employed in Hong Kong; or
- (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in Hong Kong to which the employee was attached, whether or not he was also attached elsewhere.

(3) In sections 57 to 60 and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.

(4) Any references in sections 57 to 60—

- (a) to a patent are references to a patent or other forms of protection for an invention;
- (b) to a patent being granted are references to its being granted, whether under the law of Hong Kong or the law in force in any other country, territory or area or under any treaty or international convention.

(5) For the purposes of sections 58 and 59 the benefit derived or expected to be derived by an employer from a patent shall, where he dies before any award is made under section 58 in respect of the patent, include any benefit derived or expected to be derived from the patent by his personal representatives or by any person in whom the patent was vested by their assent.

(6) Where an employee dies before an award is made under section 58 in respect of a patented invention made by him, his personal representatives or their successors in title may exercise his right to make or proceed with an application for compensation under subsection (1) or (2) of that section.

(7) In sections 58 and 59 and this section “benefit” (利益) means benefit in money or money’s worth.

(8) In section 59(2)—

“person connected with” (有關連的人), in relation to an employer, means—

- (a) where the employer is a natural person—
  - (i) a relative of the employer;
  - (ii) a partner of the employer and any relative of that partner;
  - (iii) a partnership in which the employer is a partner;
  - (iv) any corporation controlled by the employer, by a partner of the employer or by a partnership in which the employer is a partner;

- (v) any director or principal officer of any such corporation as is referred to in subparagraph (iv);
- (b) where the employer is a corporation—
  - (i) any associated corporation;
  - (ii) any person who controls the corporation and any partner of such person, and, where either such person is a natural person, any relative of such person;
  - (iii) any director or principal officer of that corporation or of any associated corporation and any relative of any such director or officer;
  - (iv) any partner of the corporation and, where such partner is a natural person, any relative of such partner;
- (c) where the employer is a partnership—
  - (i) any partner of the partnership and where such partner is a partnership any partner of that partnership, any partner with the partnership in any other partnership and where such partner is a partnership any partner of that partnership and where any partner of, or with, or in any of the partnerships mentioned in this subparagraph is a natural person, any relative of such partner;
  - (ii) any corporation controlled by the partnership or by any partner thereof or, where such a partner is a natural person, any relative of such partner;
  - (iii) any corporation of which any partner is a director or principal officer;
  - (iv) any director or principal officer of a corporation referred to in subparagraph (ii);

and for the purposes of that definition—

“associated corporation” (有聯繫法團), in relation to a person, means—

- (a) a corporation over which the person has control;
- (b) if the person is a corporation—
  - (i) a corporation which has control over the person; or
  - (ii) a corporation which is under the control of the same person as is the first-mentioned person;

“control” (控制), in relation to a corporation, means the power of a person to secure—

- (a) by means of the holding of shares or the possession of voting power in or in relation to that or any other corporation; or
- (b) by virtue of any powers conferred by the articles of association or other document regulating that or any other corporation,

that the affairs of the first-mentioned corporation are conducted in accordance with the wishes of that person;

“principal officer” (主要人員) means—



- (a) a person employed by a corporation who, either alone or jointly with one or more other persons, is responsible under the immediate authority of the directors for the conduct of the business of the corporation; or
- (b) a person so employed who, under the immediate authority of a director of the corporation or a person to whom paragraph (a) applies, exercises managerial functions in respect of the corporation;

“relative” (親屬) means the spouse, parent, child, brother or sister of the relevant person, and, in deducing such a relationship, an adopted child shall be deemed to be a child both of the natural parents and the adopting parent and a step child to be the child of both the natural parents and of any step parent.

## PART VII

### CONTRACTS AS TO PATENTED PRODUCTS, ETC.

#### 62. Avoidance of certain restrictive conditions

(1) Subject to this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or of a contract relating to any such supply or licence, shall be void in so far as it purports—

- (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the supplier or his nominee, anything other than the patented product;
- (b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the patented invention or (if it is a process) other than any product obtained directly by means of the process or to which the process has been applied;
- (c) in either case, to prohibit the person supplied or licensee from using articles (whether patented products or not) which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or licensee to use any such articles or process.

(2) Subsection (1) does not apply to contracts made or licences granted before the commencement of this Ordinance.

(3) In proceedings against any person for infringement of a patent it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or a licence under the patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.

(4) A condition or term of a contract or licence shall not be void by virtue of this section if—

- (a) at the time of the making of the contract or granting of the licence the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or licensee, on reasonable terms specified in the contract or licence and without any such condition or term as is mentioned in subsection (1); and
- (b) the person supplied or licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party 3 months' notice in writing and subject to payment to that other party of such compensation (being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence) as may in default of agreement between the parties be determined by an arbitrator appointed by the parties.

(5) If in any proceeding it is alleged that any condition or term of a contract or licence is void by virtue of this section it shall lie on the supplier or licensor to prove the matters set out in subsection (4)(a).

(6) A condition or term of a contract or licence shall not be void by virtue of this section by reason only—

- (a) that it prohibits any person from selling goods other than those supplied by a specified person; or
- (b) in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the bailor or licensor, or his nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

[*cf.* 1977 c. 37 s. 44 U.K.]

### 63. Determination of parts of certain contracts

(1) This section applies to—

- (a) any contract for the supply of a patented product;
- (b) any licence to work a patented invention; or
- (c) any contract relating to any such supply or licence,

where the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force.

(2) Notwithstanding anything to the contrary in the contract or licence or in any other contract, a contract or licence to which this section applies may to the extent (and only to the extent) that the contract or licence relates to the product or invention, be determined by either party on giving 3 months' notice in writing to the other party.

(3) In subsection (1) "patented product" (專利產品) and "patented invention" (專利發明) include respectively a product and an invention which is the subject of an application for a patent, and that subsection shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence in question, on an application for a patent which had been filed before that time, as it applies to a patent in force at that time.

(4) If, on an application under this subsection made by either party to a contract or licence falling within subsection (1), the court is satisfied that, in consequence of the patent or patents concerned ceasing to be in force, it would be unjust to require the applicant to continue to comply with all terms and conditions of the contract or licence, it may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.

(5) The foregoing provisions of this section apply to contracts and licences whether made before or after the commencement of this section.

(6) The provisions of this section shall be without prejudice to any rule of law relating to the frustration of contracts and any right of determining a contract or licence exercisable apart from this section.

[*cf.* 1977 c. 37 s. 45 U.K.]

## PART VIII

### COMPULSORY LICENCES FOR STANDARD PATENTS

#### 64. Compulsory licences for standard patents

(1) At any time after the expiration of 3 years from the date of grant of a standard patent any person may apply to the court on one or more of the grounds specified in subsection (2)—

- (a) for a licence under the patent;
  - (b) where the applicant is the Government, for the grant of a licence under the patent to any person specified in the application.
- (2) The grounds referred to in subsection (1) are—

- (a) where the patented invention is capable of being commercially worked in Hong Kong, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;
- (b) where the patented invention is a product, that a demand for the product in Hong Kong is not being met on reasonable terms;
- (c) where the patented invention is capable of being commercially worked in Hong Kong by manufacture, that it is being prevented or hindered from being so worked—
  - (i) in the case of a product, by the importation of the product; or
  - (ii) in the case of a process, by the importation of a product obtained directly by means of the process or to which the process has been applied;
- (d) that by reason of the refusal by the proprietor of the patent to grant a licence or licences on reasonable terms—
  - (i) the working or efficient working in Hong Kong of any other patented invention which involves an important technical advance of considerable economic significance in relation to the patent is prevented or hindered; or
  - (ii) the establishment or development of commercial or industrial activities in Hong Kong is unfairly prejudiced; or
- (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent or the establishment or development of commercial or industrial activities in Hong Kong, is unfairly prejudiced.

(3) The court may, if it is satisfied that any of those grounds are established, and subject to subsections (4) and (5), order the grant of a licence on such terms as it thinks fit—

- (a) to the applicant, where the application is made under subsection (1)(a); or
- (b) to the person specified in the application, where the application is made under subsection (1)(b).

(4) Where the application is made on the ground that the patented invention is not being commercially worked in Hong Kong or is not being so worked to the fullest extent that is reasonably practicable, and it appears to the court that the time which has elapsed since the grant of the patent was advertised in the Gazette has for any reason been insufficient to enable the invention to be so worked, the court may adjourn the hearing for such period as will in the opinion of the court give sufficient time for the invention to be so worked.

(5) No order shall be made under this section unless the court is satisfied that the applicant has made reasonable efforts to obtain authorization from the proprietor on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.

(6) No order shall be made under this section in respect of a patent ("patent A") on the ground mentioned in subsection (2)(d)(i) unless the court is satisfied that the proprietor of the patent for the other invention ("patent B") is able and willing to grant to the proprietor of patent A and his licensees a licence under patent B on reasonable terms.

(7) An order granting a licence under this section shall provide—

(a) that the licence shall be non-exclusive; and

(b) that such licence shall be non-assignable except with that part of the enterprise or goodwill which enjoys the use of the patent under the licence, and in the case of a licence granted under subsection (6) the licence in respect of patent A shall only be assignable with the assignment of the licence on patent B,

and shall specify the scope and duration of such licence.

(8) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped from relying on any of the matters specified in subsection (2) because of any admission made by him, whether in such licence or otherwise or by reason of his having accepted such licence.

[*cf.* 1977 c. 37 s. 48 U.K.]

## **65. Provisions about licences under section 64**

(1) Where the court is satisfied, on an application made under section 64 in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, the court may (subject to the provisions of that section) order the grant of licences under the patent to such customers of the applicant as it thinks fit as well as to the applicant.

(2) Where an application under section 64 is made in respect of a patent by a person who holds a licence under the patent, the court may—

(a) if it orders the grant of a licence to the applicant, order the existing licence to be cancelled; or

(b) instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

[*cf.* 1977 c. 37 s. 49 U.K.]

**66. Exercise of powers on applications under section 64**

(1) The powers of the court on an application under section 64 in respect of a patent shall be exercised with a view to securing the following purposes—

- (a) that inventions which can be worked on a commercial scale in Hong Kong and which should in the public interest be so worked shall be worked there without undue delay and to the fullest extent that is reasonably practicable;
- (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;
- (c) that the interests of any person for the time being working or developing an invention in Hong Kong under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to subsection (1), the court shall, in determining whether to make an order in pursuance of such an application, take account of the following matters—

- (a) the nature of the invention, the time which has elapsed since the grant of the patent was advertised in the Gazette and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention;
- (b) the ability of any person to whom a licence would be granted by the court to work the invention to the public advantage;
- (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,

but the court shall not be required to take account of any such matter occurring subsequent to the making of the application.

(3) Any person aggrieved by an order made under section 64 or 65 may apply to the court for an order for the variation or cancellation of the licence if the court in all the circumstances should think fit.

*[cf. 1977 c. 37 s. 50 U.K.]*

**67. Opposition to application under sections 64 to 66**

The proprietor of the patent concerned or any other person wishing to oppose an application under sections 64 to 66 may, in accordance with rules of court, give to the court notice of opposition; and the court shall consider the opposition in deciding whether to grant the application.

*[cf. 1977 c. 37 s. 52 U.K.]*

## PART IX

## GOVERNMENT USE OF PATENTED INVENTIONS

**68. Declaration of extreme urgency**

The Governor in Council may, for the purposes of applying sections 69 to 71, by regulation declare a period of extreme urgency whenever he considers it to be necessary or expedient in the public interest for the maintenance of supplies and services essential to the life of the community or for securing sufficient supplies and services essential to the life of the community.

**69. Government use of patents during a period of extreme urgency**

(1) During a period of declared extreme urgency a public officer authorized in writing by the Governor or any person authorized in writing by such public officer may in relation to—

- (a) a patented invention, without the consent of the proprietor of the patent; or
- (b) an invention in respect of which an application for a patent has been filed, without the consent of the applicant,

do any act in Hong Kong in relation to the invention as appears to the public officer or person authorized to be necessary or expedient in connection with the urgency giving rise to the declaration under section 68.

(2) Any act done in relation to an invention by virtue of this section is in the following provisions of this section referred to as use, or Government use, of the invention; and “use” (微用), in relation to an invention, in section 70 to 72 shall be construed accordingly.

(3) Government use may include any act which would, apart from this section, amount to an infringement of the patent concerned or, as the case may be, give rise to a right under section 88 to bring proceedings in respect of the application for a standard patent.

- (4) Any Government use of the invention made at any time either—
  - (a) after the publication of an application for a standard patent or the grant of a short-term patent for the invention; or
  - (b) without prejudice to paragraph (a), in consequence of a relevant communication made otherwise than in confidence—
    - (i) after the deemed date of filing of the application for the standard patent for the invention or the date of filing of the application of the short-term patent for the invention, as the case may be; or
    - (ii) where priority was claimed, after the date of priority,

shall be made on such terms as may be agreed, either before or after the use, by the Government and the proprietor of the patent or as may in default of agreement be determined by the court on a reference under section 72.

(5) Where an invention is used by virtue of this section at any time after publication of an application for a standard patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) include terms as to payment for the use, then (notwithstanding anything in those terms) any such payment shall be recoverable only—

(a) after such a patent is granted; and

(b) if (apart from this section) the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application as published.

(6) The authority of a public officer in respect of an invention may be given under this section either before or after the patent is granted, and may be given to any person whether or not he is authorized directly or indirectly by the proprietor of the patent to do anything in relation to the invention.

(7) Where any Government use of an invention is made by or with the authority of a public officer under this section, then the public officer shall notify the proprietor of the patent as soon as practicable, and furnish him with such information as to the extent of the use as he may from time to time require.

(8) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Government.

(9) Any reference in this section to a patented invention, in relation to any time, is a reference to an invention to which a patent has before that time been, or is subsequently, granted.

(10) In this section “relevant communication” (有關通訊), in relation to an invention, means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title.

(11) Subsection (4) is without prejudice to any rule of law relating to the confidentiality of information.

[*cf.* 1977 c. 37 ss. 55 & 56 U.K.]

## **70. Rights of third parties in respect of Government use**

(1) The provisions of any licence, assignment or agreement specified in subsection (3) are of no effect in relation to—

(a) any Government use of an invention by a public officer, or a person authorized by a public officer, by virtue of section 69; or



- (b) anything done for Government use to the order of a public officer by the proprietor of a patent in respect of a patented invention or by the proprietor of an application in respect of an invention for which an application for a patent has been filed and is still pending,

so far as those provisions—

- (i) restrict or regulate the working of the invention, or the use of any model, document or information relating to it; or  
(ii) provide for the making of payments in respect of, or calculated by reference to, such working or use.

(2) The reproduction or publication of any model or document in connection with a working or use referred to in subsection (1) shall not be deemed to be an infringement of any copyright or protected layout-design (topography) subsisting in the model or document.

(3) The licence, assignment or agreement referred to in subsection (1) is any licence, assignment or agreement which is made, whether before or after the date of commencement of this Ordinance, between any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title (on the one hand), and any person whatever other than the Government (on the other hand).

(4) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the working of the invention is in force under the patent or application concerned, then—

- (a) section 69(4) applies in relation to anything done in respect of the invention which, but for this section and section 69(1), would be an infringement of the rights of the licensee, with the substitution in those provisions of reference to the proprietor of the patent with reference to the licensee; and  
(b) section 69(4) does not apply in relation to anything done in respect of the invention by the licensee by virtue of an authority given under section 69(1).

(5) Subject to subsection (4), where the patent, or the right to the grant of the patent, has been assigned to the proprietor of the patent or application in consideration of royalties or other benefits determined by reference to the working of the invention, then—

- (a) section 69(4) applies in relation to any Government use of the invention as if reference to the proprietor of the patent included a reference to the assignor, and any sum payable for Government use under that subsection shall be divided between those persons in such proportion as may be agreed on by them or as may in default of agreement be determined by the court on a reference under section 72; and

(b) section 69(4) applies in relation to any act done in respect of the invention for Government use by the proprietor of the patent or application to the order of a public officer, as if that act were use made by virtue of an authority given under that section.

(6) Where section 69(4) applies to any use of an invention and a person holds an exclusive licence under the patent or application concerned (other than such a licence as is mentioned in subsection (4)) authorizing him to work the invention, then subsections (8) and (9) shall apply.

(7) In subsections (8) and (9) “the section 69(4) payment” (第 69(4) 條付款) means such payment (if any) as the proprietor of the patent or application and the Government agree under section 69, or the court determines under section 72, should be made by the public officer concerned to the proprietor in respect of the use of the invention.

(8) The licensee shall be entitled to recover from the proprietor of the patent or application such part (if any) of the section 69(4) payment as may be agreed on by them or as may in default of agreement be determined by the court under section 72 to be just having regard to any expenditure incurred by the licensee—

(a) in developing the invention; or

(b) in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention.

(9) Any agreement by the proprietor of the patent or application and the Government under section 69(4) as to the amount of the section 69(4) payment shall be of no effect unless the licensee consents to the agreement; and any determination by the court under section 69(4) as to the amount of that payment shall be of no effect unless the licensee has been informed of the reference to the court and is given an opportunity to be heard.

(10) In this section “the public officer concerned” (有關公職人員), in relation to any Government use of an invention, means the public officer by whom or on whose authority the use was made.

[*cf.* 1977 c. 37 s. 57 U.K.]

## 71. Compensation for loss of profit

(1) Where Government use is made of an invention, the Government shall pay—

(a) to the proprietor of the patent; or

(b) if there is an exclusive licence in force in respect of the patent, to the exclusive licensee,

compensation for any loss resulting from his not being awarded a contract to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process.

(2) Compensation is payable only to the extent that such a contract could have been fulfilled from the existing manufacturing or other capacity of the proprietor or licensee; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.

(3) In determining the loss, regard shall be had to the profit which would have been made on such a contract and to the extent to which any manufacturing or other capacity was under-used.

(4) No compensation is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process, otherwise than for Government use.

(5) The amount payable shall, if not agreed between the proprietor or licensee and the Government, be determined by the court on a reference under section 72, and is in addition to any amount payable under section 69 or 70.

[*cf.* 1977 c. 37 s. 57A U.K.]

## 72. References of disputes as to Government use

(1) Any dispute as to—

(a) the exercise by a public officer, or a person authorized by a public officer, of the powers conferred by section 69;

(b) terms for Government use of an invention under section 69;

(c) the right of any person to receive any part of a payment made in pursuance of section 69(4); or

(d) the right of any person to receive a payment under section 71, may be referred to the court by either party to the dispute after a patent has been granted for the invention.

(2) In determining under this section any dispute between the Government and any person as to the terms for the Government use of an invention, the court shall have regard—

(a) to any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from any public officer in respect of the invention in question;

(b) to whether that person or any person from whom he derives title has in the court's opinion without reasonable cause failed to comply with a request of the public officer concerned for Government use of the invention on reasonable terms.

(3) On a reference under this section the court may refuse to grant relief by way of compensation in respect of Government use of an invention—

(a) during any further period specified under section 33(4), but before payment of the maintenance fee and any additional fee prescribed for the purposes of that section; or

(b) during any further period specified under section 39(4) or 126(5) (as the case may be), but before the payment of the renewal fee and any additional fee prescribed for the purposes of that section.

(4) Where an amendment of the specification of a patent has been allowed under this Ordinance or has been recorded under section 43(2), the court shall not grant relief by way of compensation under this section in respect of any such use before the decision to allow the amendment or the recording of the amendment unless the court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

(5) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (6), grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used in Government use.

(6) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of compensation, costs or expenses except where the proprietor of the patent proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses and as to the date from which compensation should be awarded.

(7) As a condition of any such relief the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 102, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

(8) In considering the amount of any compensation for Government use of an invention after publication of an application for a standard patent for the invention and before such a patent is granted, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published that a patent would be granted conferring on the proprietor of the patent protection for an act of the same description as that found to constitute that use, and if the court finds that it would not have been reasonable, it shall reduce the compensation to such amount as it thinks just.

(9) Where a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent (the new proprietor or licensee) by virtue of a transaction, instrument or event to which section 52 applies, then unless—

- (a) an application for registration of the prescribed particulars of the transaction, instrument or event is made before the end of the period of 6 months beginning with its date; or

(b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter, the new proprietor or licensee shall not be entitled to any compensation under section 69(4) (as it stands or as modified by section 70(4)) or to any compensation under section 71 in respect of any use of the patented invention by a public officer or a person authorized by a public officer under section 69 after the date of the transaction, instrument or event and before the prescribed particulars of the transaction, instrument or event are registered.

(10) One of 2 or more joint proprietors of a patent or application for a patent may without the concurrence of the others refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

[*cf.* 1977 c. 37 s. 58 U.K.]

## PART X

### EFFECTS OF PATENT AND PATENT APPLICATION

#### 73. Prevention of direct use of invention

A patent while it is in force shall confer on its proprietor the right to prevent all third parties not having his consent from doing in Hong Kong all or any of the following—

- (a) in relation to any product which is the subject-matter of the patent—
  - (i) making, putting on the market, using or importing the product; or
  - (ii) stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise;
- (b) in relation to any process which is the subject-matter of the patent—
  - (i) using the process; or
  - (ii) offering the process for use in Hong Kong when the third party knows, or it is obvious to a reasonable person in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent;
- (c) where the invention is a process, then in relation to any product obtained directly by means of that process—
  - (i) putting on the market, using or importing the product; or

- (ii) stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise.  
[*cf.* 1992 No. 1 s. 40 *Eire*]

#### 74. Prevention of indirect use of invention

(1) A patent while it is in force shall also confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply in Hong Kong a person, other than a party entitled to work the patented invention, with means, relating to an essential element of that invention, for putting it into effect, when the third party knows, or it is obvious in the circumstances to a reasonable person, that the said means are suitable and intended for putting that invention into effect in Hong Kong.

(2) Subsection (1) shall not apply when the means referred to therein are staple commercial products, unless the supply or offering is made for the purpose of inducing the person supplied or, as the case may be, to whom the offer is made to commit acts which the proprietor of a patent is enabled to prevent by virtue of section 73.

(3) Persons performing acts referred to in section 75(a), (b) or (c) shall not be considered to be parties entitled to work an invention pursuant to subsection (1).

(4) For the purposes of subsection (1)—

- (a) reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 69; and
- (b) a person who by virtue of section 30, 35, 39(4), 41(4) or (5), 83, 106(4) or 126(5) (including, in the case of section 41, that section as applied by section 127) is entitled to do an act in relation to the invention without it constituting an infringement of a patent for the invention shall, so far as concerns that act, be treated as a person entitled to work the invention.

[*cf.* 1992 No. 1 s. 41 *Eire*]

#### 75. Limitation of effect of patent

The rights conferred by a patent shall not extend to—

- (a) acts done privately for non-commercial purposes;
- (b) acts done for experimental purposes relating to the subject-matter of the relevant patented invention;

- (c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription issued by a registered medical practitioner or registered dentist (which terms bear the meaning assigned to them by section 2 of the Medical Registration Ordinance (Cap. 161) and section 2(1) of the Dentists Registration Ordinance (Cap. 156) respectively) or acts concerning the medicine so prepared;
- (d) the use of the invention which is the subject of the patent—
  - (i) on board vessels registered in any of the Paris Convention countries or WTO member countries, territories or areas, other than Hong Kong; or
  - (ii) in the body of such vessels, or in the machinery, tackle, gear or other accessories of such vessels, when such vessels temporarily or accidentally enter the territorial waters of Hong Kong, but only if the invention is used in such waters exclusively for the needs of the vessel;
- (e) the use of the invention which is the subject of the patent in the construction or operation of—
  - (i) aircraft, hovercraft or land vehicles of Paris Convention countries or WTO member countries, territories or areas, other than Hong Kong; or
  - (ii) such aircraft, hovercraft or land vehicle accessories, when such aircraft, hovercraft or land vehicles temporarily or accidentally enter Hong Kong;
- (f) the use of an aircraft to which section 10(4) of the Civil Aviation Ordinance (Cap. 448) applies which has lawfully entered or is lawfully crossing Hong Kong (including the air space above it and its territorial waters), or the importation into Hong Kong, or the use or storage there, of any part or accessory for such an aircraft.

[*cf.* 1992 No. 1 s. 42 *Eire*]

## **76. Extent of invention**

- (1) For the purposes of this Ordinance—
  - (a) an invention in respect of which an application for a patent has been filed shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application, as interpreted by the description and any drawings contained in that specification;

(b) an invention for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the patent, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or an application for a patent shall be determined accordingly.

(2) Where more than one invention is specified in any such claim in relation to a patent or an application for a patent, each invention may have a different date of priority for the purposes of this Ordinance.

(3) Subsection (1) should not be interpreted in either of the following senses, namely—

(a) in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims, on the one hand; or

(b) in the sense that the claims serve only as a guideline and that the actual protection conferred by a patent may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated, on the other hand,

but rather is to be interpreted as defining a position between these extremes which combines a fair protection for the proprietor of the patent or the application for a patent with a reasonable degree of certainty for third parties.

[*cf.* 1977 c. 37 s. 125 U.K.]

## 77. Disclosure of invention

The application for and specification of a patent for an invention shall disclose the invention to which it relates in a manner sufficiently clear and complete for it to be performed by a person skilled in the art.

[*cf.* EPC Art. 83]

## 78. The claims

The claims shall define the matter for which protection is given or sought, be clear and concise and be supported by the description.

[*cf.* EPC Art. 84; 1992 No. 1 s. 20 Eire]



**79. The abstract**

The abstract shall only serve for use as technical information; it may not be taken into account for any other purpose and in particular it may be used neither for the purpose of interpreting the scope of the protection given nor for the purpose of applying section 94(3).

[*cf. EPC Art. 85; 1992 No. 1 s. 22(1) Eire*]

**PART XI****INFRINGEMENT****80. Proceedings for infringement of patent**

(1) Subject to this Part, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act of infringement which he alleges he is entitled under sections 73 to 75 to prevent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made—

- (a) for an injunction restraining the defendant from any apprehended act of such infringement;
- (b) for an order requiring the defendant to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which the product is inextricably comprised;
- (c) for damages in respect of the infringement;
- (d) for an account of the profits derived by the defendant from the infringement;
- (e) for a declaration that the patent is valid and has been infringed by the defendant.

(2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

(3) Subject to this Part, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court shall apply the principles applied by the court in relation to that kind of relief immediately before the commencement of this Part.

[*cf. 1977 c. 37 s. 61 U.K.; 1992 No. 1 s. 47 Eire*]

**81. Restrictions on recovery of damages for infringement**

(1) In proceedings for the infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed.

(2) For the purposes of subsection (1) a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented” or “專利” or “取得專利”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.

(3) In proceedings for infringement of a patent the court may, if it thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during any further period specified under section 39(4) or 126(5), as the case may be, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

(4) Where an amendment of the specification of a patent has been allowed under this Ordinance, no damages shall be awarded in any proceedings for an infringement of the patent committed before the date of the decision to allow the amendment or of the recording of the amendment pursuant to section 43(2), as the case may be, unless the court is satisfied that the specification of the patent as originally published was framed in good faith and with reasonable skill and knowledge.

(5) Without limiting the effect of subsection (4), where an order has been made by the court under section 46(1) allowing an amendment of the specification of a patent, no damages shall be awarded in any proceedings for an infringement of the patent committed after the date on which the order is made and before a copy of the order is filed with the Registrar for the purposes of section 46(5).

[*cf.* 1977 c. 37 s. 62 U.K.]

## **82. Relief for infringement of partially valid patent**

(1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court may, subject to subsection (2), grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of damages or costs, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court as to costs and as to the date from which damages should be reckoned.

(3) As a condition of relief under subsection (1) or (2) the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 102, and such an application may be made whether or not all other issues in the proceedings have been determined.

[*cf.* 1977 c. 37 s. 63 U.K.]

### 83. Right to continue use begun before priority date

(1) Where a patent is granted for an invention, a person who in Hong Kong before the deemed date of filing of the application for the standard patent or the date of filing of the application for the short-term patent (as the case may be) or, if priority was claimed, before the date of priority—

- (a) does in good faith an act which would constitute an infringement of the patent if it were in force; or
- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (2).

(2) The rights referred to in subsection (1) are—

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (1);
- (b) if such act was done or preparations had been made to do it in the course of a business—
  - (i) in the case of an individual—
    - (A) the right to assign the right to do it or to transmit such right on death; or
    - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
  - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1).

(4) Where a patented product is disposed of to another in exercise of a right conferred by subsection (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by a registered proprietor of the patent.

[*cf.* 1992 No. 1 s. 55 *Eire*]

#### **84. Certificate of contested validity of patent**

(1) If in any proceedings before the court the validity of a patent to any extent is contested and that patent is found by the court to be wholly or partially valid, the court may certify the finding and the fact that the validity of the patent was so contested.

(2) Where a certificate is granted under this section, then if, in any subsequent proceedings before the court for infringement of the patent concerned or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent that party shall, unless the court otherwise directs, be entitled to his costs on the indemnity basis within the meaning of that term as appearing in Order 62 rule 28 of the Rules of the Supreme Court (Cap. 4 sub. leg.) (other than the costs of any appeal in the subsequent proceedings).

[*cf.* 1977 c. 37 s. 65 U.K.]

#### **85. Proceedings for infringement by a co-owner**

(1) In the application of section 73 to a patent of which there are 2 or more joint proprietors the reference to the proprietor shall be construed—

- (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 54 or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and
- (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 54 or any such agreement, is or are the proper person or persons to give the requisite consent.

(2) One of 2 or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings, but any of the others made a defendant in pursuance of this subsection shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

[*cf.* 1977 c. 37 s. 66 U.K.]

#### **86. Proceedings for infringement by exclusive licensee**

(1) Subject to this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in the provisions of this Ordinance relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section the proprietor of the patent shall be made a party to the proceedings, but if made a defendant in pursuance of this subsection shall not be liable for costs or expenses unless he enters an appearance and takes part in the proceedings.

[*cf.* 1977 c. 37 s. 67 U.K.]

### **87. Effect of non-registration on infringement proceedings**

Where a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent by virtue of a transaction, instrument or event to which section 52 applies, then unless—

- (a) an application for registration of the prescribed particulars of the transaction, instrument or event is made before the end of the period of 6 months beginning with its date; or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the patent occurring after the date of the transaction, instrument or event and before the prescribed particulars of the transaction, instrument or event are registered.

[*cf.* 1977 c. 37 s. 68 U.K.]

### **88. Infringement of rights conferred by publication of application for standard patent**

(1) Subject to this section, where an application for a standard patent is published the applicant shall have, as from the date of publication and until the grant of the standard patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court for damages in respect of any act which would have infringed the patent.

(2) Further to subsection (1), references in sections 73, 74, 75, 80, 81 and 85 to 87—

- (a) to a patent and the proprietor of a patent, as they relate to a standard patent, shall be respectively construed as including references to the application for the standard patent and the applicant; and

(b) to a patent being in force, being granted, being valid or existing, as they relate to a standard patent, shall be construed accordingly, and for this purpose the reference in section 81(3) to section 39(4) shall be read as a reference to section 33(4).

(3) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only—

(a) after the standard patent has been granted; and

(b) if the act would, if the patent had been granted on the date of publication of the request to record, have infringed not only the standard patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the published request to record.

(4) Section 81(4) shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application for a standard patent as published that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court finds that it would not have been reasonable, it shall reduce the damages to such an amount as it thinks just.

(5) An applicant shall be deemed never to have had the rights set out in subsection (1) if the application for a standard patent is refused or withdrawn or is deemed to be withdrawn.

[*cf.* 1977 c. 37 s. 69 U.K.]

## **89. Remedy for groundless threats of infringement proceedings**

(1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in the court against the person making the threats for any such relief as is mentioned in subsection (3).

(2) In any such proceedings the plaintiff shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless—

(a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and

(b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The said relief is—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as have been sustained by the plaintiff by reason of the threats.

(4) Proceedings may not be brought under this section as regards a threat to bring proceedings for an infringement alleged to consist of making a product for putting on the market or of using a process.

(5) For the purposes of this section a notification of the existence of a patent does not of itself constitute a threat of proceedings.

[*cf.* 1977 c. 37 s. 70 U.K.]

## 90. Declaration as to non-infringement

Without prejudice to the court's jurisdiction to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown that—

- (a) that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question; and
- (b) the proprietor has refused or failed to give any such acknowledgment.

[*cf.* 1977 c. 37 s. 71 U.K.]

## PART XII

### REVOCATION OF PATENTS

#### General provisions

## 91. Power to revoke patents on application

(1) Subject to this Ordinance, the court may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say—

- (a) that the invention is not a patentable invention;
- (b) that the patent was granted to a person who was not entitled to be granted that patent;

- (c) that the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be performed by a person skilled in the art;
  - (d) that the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a new application filed under section 55(4) or as mentioned in section 22 or 116, in the earlier application for a patent as filed;
  - (e) that the protection conferred by the patent has been extended by an amendment of the application for the patent or the specification of the patent which is invalid;
  - (f) that the patent is one of 2 standard patents for the same invention, the applications for which were filed by the same person and have the same deemed date of filing;
  - (g) that the patent is one of 2 short-term patents for the same invention, the applications for which were filed by the same person and have the same date of filing;
  - (h) that—
    - (i) the patent is one of 2 patents for the same invention, one such patent being a standard patent and the other being a short-term patent, the applications for which were filed by the same person and have the same deemed date of filing or date of filing; and
    - (ii) the 2 patents are not under the proprietorship of the same person;
  - (i) in the case of a standard patent, that the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.
- (2) An order under this section may be—
- (a) an order for the unconditional revocation of the patent; or
  - (b) where the court determines that one of the grounds mentioned in subsection (1)(a) to (h) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 102 to the satisfaction of the court.
- (3) In subsection (1)(f), (g) and (h)—
- (a) reference to the date of filing or deemed date of filing of an application for a patent shall be read as a reference to that date or, if priority was claimed in respect of the application, to the date of priority of the application;
  - (b) reference to the applications for 2 patents being filed by the same person shall be read as a reference to that case or to the case where—



- (i) the person filing one of the applications is the successor in title to the person filing the other application; or
- (ii) the persons filing the applications are both successors in title to the same former proprietor of the invention.

[*cf.* 1977 c. 37 s. 72 U.K.; EPC Art. 138]

## 92. Application for revocation

(1) An application for the revocation of a patent on the ground mentioned in section 91(1)(b)—

- (a) may be made only by a person found by the court in an action for a declaration or on a reference under section 55 to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked, or in case more than one person is found to be so entitled, by all those persons; and
- (b) notwithstanding paragraph (a), may not be made if the action for a declaration was commenced or the reference under section 55 was made after the end of the period of 2 years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(2) On an application for the revocation of a patent on the ground mentioned in section 91(1)(f), (g) or (h), the court shall not make an order for revocation unless the proprietor of each patent has been allowed an opportunity of making observations and of amending the specification of the patent, and if the proprietors fail to satisfy the court that there are not 2 patents in respect of the same invention, or to amend one or both specifications so as to prevent there being 2 patents in respect of the same invention, the court shall revoke the patent having the shorter remaining period in force under section 39(1) or 126(1) (as may be appropriate) or, if both patents have the same remaining period in force, shall revoke any one of the patents.

[*cf.* 1977 c. 37 s. 72 U.K.]

## Patentable inventions

### 93. Patentable inventions

(1) An invention is patentable if it is susceptible of industrial application, is new and involves an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning of subsection (1)—

- (a) a discovery, scientific theory or mathematical method;
- (b) an aesthetic creation;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
- (d) the presentation of information.

(3) Subsection (2) shall exclude patentability of subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to such subject-matter or activities as such.

(4) A method for treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body shall not be regarded as an invention which is susceptible of industrial application for the purposes of subsection (1), but this subsection shall not apply to a product, and in particular a substance or composition, for use in any such method.

(5) An invention the publication or working of which would be contrary to public order (“ordre public”) or morality shall not be a patentable invention; however, the working of an invention shall not be deemed to be so contrary merely because it is prohibited by any law in force in Hong Kong.

(6) A plant or animal variety or an essentially biological process for the production of plants or animals, other than a microbiological process or the products of such a process, shall not be patentable.

[*cf. EPC Art. 52 & 53; 1977 c. 37 ss. 1 & 4 U.K.; 1992 No. 1 ss. 9 & 10 Eire*]

#### 94. Novelty

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public (whether in Hong Kong or elsewhere) by means of a written or oral description, by use, or in any other way—

- (a) before the deemed date of filing of an application for a standard patent for the invention or, if priority was claimed, before the date of priority; or
- (b) before the date of filing of an application for a short-term patent for the invention or, if priority was claimed, before the date of priority,

whichever is the earlier.

(3) Additionally, the state of the art shall be considered as comprising the content of—

- (a) any application for a standard patent as filed, of which—
  - (i) the deemed date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and

- (ii) the corresponding designated patent application was published in the designated patent office on or after the date referred to in subsection (2);
- (b) any designated patent application as filed in a designated patent office—
  - (i) of which the date of filing or, if priority was claimed in the designated patent office, the date of priority accorded in the designated patent office is before the date referred to in subsection (2); and
  - (ii) which was published by the designated patent office on or after the date referred to in subsection (2); or
- (c) any application for a short-term patent—
  - (i) of which the date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and
  - (ii) pursuant to which a short-term patent was published under this Ordinance on or after the date referred to in subsection (2).

(4) Subsections (1) to (3) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in section 93(4) where its use for any method referred to in that subsection is not comprised in the state of the art.

[*cf. EPC Art. 54; 1977 c. 37 s. 2 U.K.; 1992 No. 1 s. 11 Eire*]

#### **95. Non-prejudicial disclosure in case of standard patent application**

(1) For the application of section 94 in the case of a standard patent application, but subject to section 15(2)(f), a disclosure of the invention shall not be taken into consideration if it occurred no earlier than 6 months before the deemed date of filing of the application and if it was due to, or in consequence of—

- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
- (b) the fact that the applicant or any proprietor of the invention for the time being has displayed the invention at a prescribed exhibition or meeting.

(2) Subsection (1)(b) shall only have effect if, at the time of filing the corresponding designated patent application, the applicant stated in accordance with the law of the designated patent office relating to non-prejudicial disclosure that the invention had been so displayed.

[*cf. EPC Art. 55*]

## 96. Inventive step

(1) An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

(2) For the purpose of subsection (1), if the state of the art also includes documents within the meaning of section 94(3), these documents are not to be considered in deciding whether there has been an inventive step.

[*cf. EPC Art. 56*]

## 97. Industrial application

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

[*cf. EPC Art. 57*]

### Priority for standard patent application

## 98. Priority right

(1) This section applies to the proprietor of a designated patent application for an invention who, on the basis of an earlier application in a Paris Convention country for a patent or other protection for the same invention, enjoys under the law of the designated patent office a right of priority for the period of 12 months after the date of filing the earlier application.

(2) Such person or his successor in title shall enjoy, for the purposes of filing an application for a standard patent for the invention which is the subject of the designated patent application, the same right of priority as he enjoys in respect of the designated patent application under the law of the designated patent office.

(3) Subsections (1) and (2) also apply where—

- (a) the earlier application was filed in a country, territory or area which is not a Paris Convention country; and
- (b) the right of priority enjoyed in the designated patent office is granted consequent upon an international agreement to which Hong Kong is a party or which is otherwise applied to Hong Kong by a party to the agreement, which agreement provides for the grant of such priority on the basis of a first filing made in or for that country, territory or area and subject to conditions equivalent to those laid down in the Paris Convention.

(4) Reference in this section to the law of a designated patent office includes reference to the law of the designated patent office dealing with the circumstances under which—

- (a) a filing in a Paris Convention country that is equivalent to a regular national filing under the domestic legislation of that country or under bilateral or multilateral agreements gives rise to a right of priority;
- (b) a subsequent application for a patent for the same subject-matter as a previous first application and filed in or in respect of the same Paris Convention country is to be considered as the first application for the purposes of determining priority;
- (c) multiple priorities may be claimed in respect of a designated patent application.

(5) The rights conferred by this section are subject to sections 15(2)(e) and 23(3)(c).

(6) In this section, “Paris Convention country” (巴黎公約國) means a country or territory other than Hong Kong which is a party to the Paris Convention or a dependent territory of any such country to which that Convention has been extended.

[*cf. EPC Art. 87 & 88; 1992 No. 1 ss. 25 & 26 Eire; 1977 c. 37 s. 5 U.K.*]

## 99. Effect of priority right

(1) The right of priority conferred under section 98 shall have the effect that the date of priority enjoyed in the designated patent office shall be regarded as being the date of priority of the standard patent application for the purposes of this Ordinance.

(2) A patent granted pursuant to a standard patent application in respect of which the proprietor enjoys a right of priority as provided in section 98 shall not be invalidated by reason only of the fact that any subject-matter disclosed in the earlier application (that is to say, the application on the basis of which the right of priority is enjoyed in the designated patent office) was made available to the public at any time after the date of filing of the earlier application.

[*cf. EPC Art. 89; 1992 No. 1 s. 27 Eire*]

## Right to a patent

### 100. Right to a patent to belong to inventor

(1) Except as provided in subsection (2), the right to a patent shall belong to the inventor or his successor in title.

(2) If the inventor is an employee, the right to the patent shall be determined in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed or, if the identity of such country, territory or area cannot be determined, in accordance with the law of the country, territory or area in which the employer has his place of business to which the employee is attached.

(3) If 2 or more persons have made an invention independently of each other, the right to the patent shall belong—

- (a) as between persons who have applied for or been granted a standard patent for the invention, to the person in respect of whose application for the standard patent the date of filing of the corresponding designated patent application or, if priority was claimed, the date of priority, is the earlier or earliest; or
- (b) as between persons who have applied for or been granted a short-term patent for the invention, to the person in respect of whose application for a short-term patent the date of filing or, if priority was claimed, the date of priority, is the earlier or earliest; or
- (c) where one or more of the persons has applied for or been granted a standard patent and one or more of the persons has been granted a short-term patent, to the person in respect of whose application the date specified in paragraphs (a) and (b) (as may be appropriate) is the earlier or earliest,

but in the application of paragraphs (a) and (c) regard shall only be had to an application for a standard patent that has been published under this Ordinance.

[*cf.* EPC Art. 60; 1992 No. 1 s. 16 *Eire*]

### Putting validity in issue

#### 101. Proceedings in which validity of patent may be put in issue

(1) Subject to the following provisions of this section, the validity of a patent may be put in issue—

- (a) by way of defence, in proceedings for infringement of the patent under section 80 or, in the case of a standard patent, in proceedings under section 88 for infringement of rights conferred by the publication of an application;
- (b) in proceedings under section 89;
- (c) in proceedings in which a declaration in relation to the patent is sought under section 90;

(d) in proceedings before the court under section 91 for the revocation of the patent;

(e) in proceedings under section 72.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Ordinance or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

(3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 91 or otherwise) are the grounds on which the patent may be revoked under that section.

(4) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground mentioned in section 91(1)(b) unless—

(a) it has been determined—

- (i) in entitlement proceedings commenced by that person; or
- (ii) in the proceedings in which the validity of the patent is in issue,

that the patent should have been granted to him and not some other person; and

(b) except in the case at paragraph (a)(i)—

- (i) the proceedings in which the validity of the patent is in issue are commenced before the end of 2 years beginning with the date of the grant of the patent; or
- (ii) it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) Where the validity of a patent is put in issue by way of defence or counterclaim the court shall, if it thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a).

(6) In subsection (4) “entitlement proceedings” (享有權法律程序), in relation to a patent, means a reference under section 55(1) on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration that it was so granted.

[*cf.* 1977 c. 37 s. 74 U.K.]

## PART XIII

### GENERAL PROVISIONS AS TO AMENDMENT OF PATENTS AND PATENT APPLICATIONS

#### 102. Amendment of patent in infringement or revocation proceedings

(1) In any proceedings before the court in which the validity of a patent is put in issue the court may, subject to section 103, allow the proprietor of the

patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court thinks fit.

(2) A person may give notice to the court of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

[*cf.* 1977 c. 37 s. 75 U.K.]

### 103. Amendments of applications and patents not to include added matter

(1) An application for a patent—

(a) which is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and

(b) which discloses additional matter, that is, matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed,

may be filed under section 55(4), or as mentioned in section 22 or 116 (as may be appropriate), but shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(2) Any amendment of an application for a standard patent filed under section 31 shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(3) Any amendment of the specification of a patent filed under section 46(1) or 102, or of the specification of a standard patent filed under section 43 shall be invalid to the extent that it—

(a) extends the subject-matter disclosed in the application as filed; or

(b) extends the protection conferred by the patent.

[*cf.* 1977 c. 37 s. 76 U.K.]

## PART XIV

### LANGUAGE OF PROCEEDINGS; AUTHENTIC TEXT

#### 104. Language of proceedings before Registrar

(1) An application for a patent must be filed in one of the official languages.



(2) Except as otherwise provided in rules made for the purposes of this section, and notwithstanding section 5 of the Official Languages Ordinance (Cap. 5), the official language in which an application for a patent is filed shall be used as the language of the proceedings in all proceedings before the Registrar concerning the application or the resulting patent.

(3) Where a designated patent application in respect of an invention is in one of the official languages, nothing in this section shall be construed as requiring an application for a standard patent in respect of that invention to be filed in the same official language.

(4) Rules may be made—

(a) requiring, in respect of any document filed or to be filed with the Registrar in proceedings under this Ordinance, the filing of a translation of the document into the language of the proceeding or into one or both official languages;

(b) providing for the use by any person in oral proceedings before the Registrar, of a language other than the language of the proceedings;

(c) in respect of documents to be used for the purpose of evidence in proceedings before the Registrar and which are in a language other than the language of the proceedings, providing for the filing of the document in that other language and the filing of a translation of the document into the language of the proceedings or into one of the official languages;

(d) in respect of information provided or to be provided to the Registrar and which is to be entered in the register, requiring the provision of that information in both official languages;

(e) specifying, in cases of entries which are made in the register in both official languages, which entry is to be authentic.

(5) Rules made for the purposes of subsection (4)(a) or (d)—

(a) may specify periods within which translations of documents into the language of the proceedings or into the official languages are to be filed or within which information in the official languages is to be provided;

(b) may provide for extensions, upon application by a party to the proceedings, of such periods, and may require that applications for such extension shall be subject to the payment of a penalty fee.

### 105. Authentic text

Except as provided in section 106, the text of a patent or an application for a patent in the language of the proceedings before the Registrar shall be the authentic text in any proceedings before the Registrar or a court.

[*cf. EPC Art. 70(1)*]

### 106. Authentic text of standard patent and standard patent application

(1) Subject to subsection (2), the text of the specification of a corresponding designated patent or corresponding designated patent application in the language of the proceedings before the designated patent office shall be the authentic text of the specification of the standard patent or standard patent application respectively for the purposes of any proceedings under this Ordinance relating to the standard patent or standard patent application before the Registrar or a court.

(2) If—

- (a) the language of the proceedings before the designated patent office is other than one of the official languages; and
- (b) the corresponding designated patent or designated patent application as translated into one of the official languages confers protection which is narrower than that conferred by it in the language of the proceedings before the designated patent office,

then a translation into one of the official languages of the specification of the corresponding designated patent or of the claims of the corresponding designated patent application shall be treated as the authentic text of the specification of the standard patent or of the claims of the standard patent application respectively for the purpose of any proceedings under this Ordinance, other than proceedings for the revocation of the patent.

(3) If any translation such as is mentioned in subsection (2) results in a designated patent or designated patent application conferring the narrower protection, the proprietor of or applicant for the standard patent may file a corrected translation with the Registrar and, if he pays the prescribed fee within the prescribed period, the Registrar shall publish it, but—

- (a) any payment for any use of the invention which (apart from section 69) would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section;
- (b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent has been granted,

unless before that use or the doing of the act the corrected translation has been published by the Registrar or the proprietor or applicant has sent the corrected translation by post or delivered it to the public officer who made use or authorized the use of the invention or, as the case may be, to the person alleged to have done that act.

(4) Where a correction of a translation is published under subsection (3) and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 69) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by section 41(4) and (5), and section 41(6) shall apply accordingly.

(5) In this section “language of the proceedings before the designated patent office” (在指定專利當局進行的法律程序的語文), in relation to a corresponding designated patent or corresponding designated patent application, means the language in which proceedings relating to that patent or application are to be conducted before the designated patent office.

[*cf.* 1977 c. 37 s. 80 U.K.]

#### **107. Amendment to patent or patent application to be in authentic text**

An amendment to the specification of a patent or to an application for a patent may only be made in the language of the authentic text of the patent or application.

### **PART XV**

#### **SHORT-TERM PATENTS**

##### **Right to short-term patent**

#### **108. Right to apply for a short-term patent**

(1) An application for a short-term patent to be granted under section 118 may be made by any person either alone or jointly with another.

(2) For the purposes of proceedings before the Registrar the applicant shall be deemed to be entitled to exercise the right to the short-term patent.

##### **Patentability**

#### **109. Non-prejudicial disclosure**

For the purposes of section 94, a disclosure of the invention shall not be taken into consideration if it occurred no earlier than 6 months before the filing of the short-term patent application and if it was due to, or in consequence of—

- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
- (b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to Hong Kong.

but paragraph (b) shall apply only if the short-term patent application as filed contains a statement to the effect that the invention has been so displayed and contains written evidence in support of the statement complying with any prescribed conditions.

[*cf. EPC Art. 55*]

### Priority

#### 110. Priority right

(1) A person who has filed—

- (a) in or for any Paris Convention country or WTO member country, territory or area, an application for a patent or other protection in respect of an invention; or
- (b) in Hong Kong, an application for a short-term patent under this Part in respect of an invention,

or his successors in title, shall enjoy, for the purpose of filing a subsequent application for a short-term patent under this Part in respect of the same invention, a right of priority for the period of 12 months after the date of filing of the first application, subject to compliance with any prescribed conditions.

(2) For the purposes of subsection (1) as it applies in the case of a filing specified in paragraph (a) of that subsection—

- (a) every filing which in a Paris Convention country or WTO member country, territory or area is equivalent to a regular national filing under its domestic legislation or under bilateral or multilateral agreements shall be recognized as giving rise to a right of priority;
- (b) a subsequent application for a patent or other protection for the same subject-matter as a previous first application and filed in or for the same Paris Convention country or WTO member country, territory or area shall be considered as the first application for the purposes of determining priority if, and only if, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority;

- (c) where pursuant to paragraph (b) a subsequent application for a patent or other protection is considered as a first application, the previous application may not thereafter serve as a basis for claiming a right of priority,

and in this subsection, “regular national filing” (正規國家提交) means any filing that establishes the date on which the application was filed, whatever may be the outcome of the application.

(3) For the purposes of subsection (1) as it applies in the case of a filing specified in paragraph (b) of that subsection –

- (a) every regular filing of an application for a short-term patent under this Part shall be recognized as giving rise to a right of priority in relation to other applications under this Part;
- (b) a subsequent application for a short-term patent under this Part for the same subject-matter as a previous first application for a short-term patent shall be considered as the first application for the purposes of determining priority if, and only if, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority;
- (c) where pursuant to paragraph (b) a subsequent application for a short-term patent is considered as a first application, the previous application for a short-term patent may not thereafter serve as a basis for claiming a right of priority,

and in this subsection “regular filing of an application for a short-term patent” (短期專利申請的正規提交) means any filing that establishes the date on which the application for the short-term patent was filed, whatever may be the outcome of the application.

(4) In this section, “application for a patent or other protection” (專利或其他保護的申請) means an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor’s certificate filed in or for any Paris Convention country or WTO member country, territory or area.

[*cf. EPC Art. 87; 1992 No. 1 s. 25 Eire*]

## 111. Claiming priority

(1) An applicant for a short-term patent desiring to take advantage of the priority of a previous application shall file in the prescribed manner a statement of priority and a copy of the previous application.

(2) Multiple priorities may be claimed in respect of a short-term patent application, notwithstanding the fact that they originated in different countries, and where appropriate, multiple priorities may be claimed for any one claim.

(3) Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

(4) If one or more priorities are claimed in respect of a short-term patent application, the right of priority shall cover only those elements of the short-term patent application which are included in the application or applications whose priority is claimed.

(5) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted if the documents of the previous application as a whole specifically disclosed such elements.

(6) Where a statement of priority is filed in accordance with this section, the applicant shall for the purpose of proceedings before the Registrar be deemed to be entitled to enjoy the right of priority shown in the statement.

[*cf. EPC Art. 88*]

## **112. Effect of priority right**

(1) The right of priority shall have the effect that the date of priority of the previous application claimed under section 111 shall be regarded as being the date of priority of the short-term patent application for the purposes of section 94(2) and (3) as it applies to this Part.

(2) Where a short-term patent application is filed and the priority of a previous application is claimed under section 111, then, notwithstanding anything contained in this Ordinance, the short-term patent application and any short-term patent granted in pursuance of it shall not be invalidated by reason only of the fact that any subject-matter disclosed in the previous application was made available to the public at any time after the date of filing of the previous application.

[*cf. EPC Art. 89*]

## **Applications**

### **113. Requirements of short-term patent application**

(1) Every application for a short-term patent shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain—

- (a) a request for the grant of a short-term patent;
  - (b) a specification which provides on the face of it for—
    - (i) a description of the invention to which the application relates;
    - (ii) one or more claims but not exceeding one independent claim;
    - (iii) any drawings referred to in the description or the claim or claims;
  - (c) an abstract; and
  - (d) a search report in relation to the invention.
- (2) An application for a short-term patent—
- (a) shall state the name and address of the applicant;
  - (b) shall identify the person or persons whom the applicant believes to be the inventor or inventors and shall specify the last known address of that person or persons;
  - (c) where the applicant is not the sole inventor or the applicants are not the joint inventors, shall contain a statement indicating the derivation of his or their entitlement to exercise the right to the short-term patent; and
  - (d) shall specify an address in Hong Kong for service of documents.
- (3) Every such application shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.
- (4) Rules may provide—
- (a) that a short-term patent application shall or may contain a title of the invention and a designation of the classification of the invention;
  - (b) for the manner in which the following matters shall or may be contained in a short-term patent application—
    - (i) any statement in accordance with subsection (2) relating to the inventor or the derivation of the applicant's right to grant;
    - (ii) any claim to the priority of an earlier patent application and supporting priority documents in accordance with section 111;
    - (iii) any request for deferral of the grant of a patent in accordance with section 119;
    - (iv) any claim regarding non-prejudicial disclosure in accordance with section 109;

(v) in relation to any invention which requires for its performance the use of a micro-organism, information concerning the availability to the public of samples of the micro-organism.

(5) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the application, and if either fee is not paid within that period or within such further period of grace as may have been allowed under subsection (6) the application shall be deemed to be withdrawn.

(6) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (5) may still be validly paid.

(7) The foregoing provisions shall not prevent any application being initiated by documents complying with section 114(2).

(8) In this section "search report" (查檢報告) means a report—

- (a) by a prescribed searching authority of a search undertaken by that authority as to the prior art in relation to the invention, based on the claims and having due regard to the description and drawings (if any); and
- (b) which contains the prescribed information.

[*cf.* 1992 No. 1 s. 18 Eire; EPC Art. 78]

#### 114. Examination on filing

(1) The Registrar shall examine whether—

- (a) the short-term patent application satisfies the requirements specified in subsection (2) for the accordance of a date of filing ("minimum requirements");
- (b) the prescribed filing fee and advertisement fee has been paid in due time.

(2) The date of filing of a short-term patent application shall be the earliest date on which documents filed by the applicant contain—

- (a) an indication that a short-term patent is sought;
- (b) information identifying the applicant;
- (c) a part which on the face of it appears to be a description of an invention.

(3) If a date of filing cannot be accorded because of deficiencies as regards the minimum requirements, the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.

(4) If the deficiencies are not corrected within the time prescribed in the rules, the application shall not be dealt with as an application for a short-term patent.

[*cf.* EPC Art. 80 & 90]



### 115. Examination as to formal requirements

(1) If a short-term patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of section 113(5), the Registrar shall examine whether the requirements of section 113 and of any rules made for the purposes of that section (the "formal requirements") have been satisfied.

(2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be corrected, he shall give the applicant an opportunity to correct them in accordance with the rules.

(3) If—

(a) there are deficiencies as regards the formal requirements which cannot be corrected the application for a short-term patent shall be refused; or

(b) any deficiencies as regards the formal requirements noted in the examination under subsection (1) are not corrected in accordance with the rules, then except as provided in subsection (4), the application for a short-term patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.

(4) If a deficiency relating solely to a claim to any right of priority is not duly corrected then such right shall be lost for the application.

[*cf. EPC Art. 91*]

### 116. Divisional short-term patent application

Where, after an application for a short-term patent has been filed and before the date under section 122 on which preparation for publication of the patent has commenced, a new application for a short-term patent is filed by the original applicant or his successor in title in accordance with the rules to be prescribed, being an application—

(a) which is in respect of any part of the subject-matter contained in the earlier short-term patent application;

(b) which complies with the relevant requirements including procedures and time limits specified in the rules; and

(c) which does not contravene section 103,

then such new application shall be treated as having, as its date of filing, the date of filing of the earlier short-term application and shall have the benefit of any right of priority.

### 117. Formality examination only

Except as expressly provided to the contrary, nothing in this Part providing for the examination by the Registrar of an application for a short-term patent for an invention shall be construed as imposing any obligation upon the Registrar to consider or to have regard to, for the purpose of such examination, any question as to—

- (a) the patentability of the invention;
- (b) whether the applicant is entitled to any priority claimed in the application;
- (c) whether the invention is properly disclosed in the application; or
- (d) any matter specified in section 45, 77, 78, 79, 93, 94, 96, 97, 100, 109, 110, 111(2) to (6) or 120(2).

### Procedure up to and including grant

### 118. Grant of short-term patent and publication

(1) If on examination by the Registrar under section 115(1) an application for a short-term patent is found to have satisfied the requirements of that provision, or if on a subsequent examination the deficiencies noted by the Registrar under section 115(2) are found to have been corrected in accordance with the rules, then as soon as practicable after such examination, but subject to sections 119 and 124, the Registrar shall grant a short-term patent for the invention.

(2) As soon as practicable after a short-term patent has been granted under this section the Registrar shall—

- (a) publish in the prescribed manner the specification of the short-term patent, the names of the proprietor and, if different, the inventor;
- (b) issue a certificate of grant; and
- (c) advertise the fact of such grant by notice in the Gazette.

(3) The Registrar may in any publication under subsection (2)(a) publish in addition to the matters specified in that subsection any other matters constituting or relating to the patent which in the Registrar's opinion it is desirable to publish.

### **119. Deferral of grant of patent at applicant's request**

(1) Where in his application for a short-term patent an applicant has requested the Registrar to defer the grant of a patent for a period specified in the application, a short-term patent shall not be granted in that application until—

(a) the expiry of that period, or of such shorter period as the applicant may subsequently specify by notice filed with the Registrar, after the date on which the requirements of section 115(1) are found to have been satisfied; or

(b) 12 months after the date of filing of the application,  
whichever occurs first.

(2) Where a request has been made under this section for the deferral of a grant, any grant under section 118(1) shall be made by the Registrar as soon as possible after the expiry of the period of deferral applying by virtue of this section.

### **120. Amendment of application for short-term patent before grant**

(1) Subject to this section and sections 122 and 103, at any time before a patent is granted under this Part an applicant may, in accordance with the prescribed conditions, amend the application of his own volition.

(2) Any amendment made under this section shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(3) The Registrar may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a short-term patent so as to acknowledge a registered trade mark.

[*cf.* 1977 c. 37 s. 19 U.K.]

### **121. Withdrawal of application**

(1) At any time before a short-term patent is granted the applicant may, subject to section 122, withdraw in writing his application and any such withdrawal may not be revoked.

(2) Where a short-term patent application is withdrawn under this section, or is deemed under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, the following provisions shall apply—

(a) the applicant shall continue to enjoy the right of priority under section 112 which he enjoyed immediately before such withdrawal or refusal;

(b) no other right may be claimed under this Ordinance in relation to the application.

## **122. Limitation on withdrawal, amendment, etc. of application**

No withdrawal of an application under section 121, no divisional application under section 116 nor any amendment under section 120 shall be allowed after the date on which preparations for publication under section 118(2) of the specification of a short-term patent to be granted in pursuance of the application have been completed.

## **123. Further processing of, and restoration of rights in respect of, short-term patent applications**

(1) Sections 28(1) and (2), 29(1) and (2) and 30 shall apply, subject to necessary modification, to an application for a short-term patent as if a reference in those sections to an application for a standard patent and to Part II were a reference to an application for a short-term patent and to this Part respectively.

(2) Section 28 as applied by subsection (1) does not apply in the case of a deemed withdrawal of an application under section 113(5).

(3) Section 29 as applied by subsection (1) does not apply in the case of a failure to comply with a time limit under section 113, 114 or 115.

## **124. Registrar may refuse to grant short-term patent**

The Registrar may refuse to grant a short-term patent for an invention if he considers that the invention is not a patentable invention by reason of any of the matters specified in section 93(5), and the Registrar shall give notice of any such refusal to the applicant.

## **125. Short-term patent application based on international application**

(1) Where an international application seeking a patent for a utility model and designating the People's Republic of China has entered its national phase in the People's Republic of China, the applicant in the international application may apply for a short-term patent for the invention (if any) disclosed in that application.

(2) An application for a short-term patent made pursuant to this section may be filed at any time before a date 6 months after the entry into the national phase of the international application in the People's Republic of China, or such other date as may be prescribed by rules.

(3) An application for a short-term patent made pursuant to this section shall contain—

- (a) a photocopy of the international application as published by the International Bureau under Article 21 of the Patent Cooperation Treaty;
- (b) a photocopy of the international search report in relation to the international application as published under Article 21(3) of the Patent Cooperation Treaty (whether contained in the international application as published or separately published);
- (c) the date of entry of the international application into the national phase in the People's Republic of China;
- (d) a photocopy of the translation of the international application (if any) published by the Chinese Patent Office; and
- (e) a photocopy of any information that may be published by the Chinese Patent Office concerning the international application.

(4) Section 113 applies in relation to an application for a short-term patent made pursuant to this section as if for subsection (1)(b) to (d) of that section there was substituted a reference to the documents specified in subsection (3)(a) to (e) of this section.

(5) Where an application made pursuant to this section results in the grant of a short-term patent, the application shall be deemed to have as its date of filing the international filing date accorded to the international application for the purposes of Article 11 of the Patent Cooperation Treaty and, in this Ordinance, reference to the date of filing of an application in relation to a short-term patent which has been granted pursuant to an application made as provided for in this section shall be construed accordingly.

(6) In this section, "Chinese Patent Office" (中國專利局) means the office established under the laws of the People's Republic of China for the granting of patents for inventions.

### **Provisions as to short-term patents after grant**

#### **126. Term of short-term patent**

- (1) A short-term patent granted under this Part—
  - (a) shall take effect on the date on which the fact of its grant is advertised in the Gazette; and
  - (b) subject to subsection (2) and (3), shall remain in force until the end of the period of 8 years beginning with the date of filing the application for the patent.

(2) If it is desired to keep a short-term patent in force for a further 4 years after the expiry of the 4th year from the date of filing of the application for that patent, the prescribed renewal fee shall be paid within the 3 months ending with the expiry of that 4th year, and a short-term patent shall cease to have effect at the expiry of that 4th year if the renewal fee is not so paid.

(3) Despite subsection (2), where the date of grant of a short-term patent occurs after the expiry of the 4th year from the date of filing of the application for that patent then—

- (a) the prescribed renewal fee may be paid at any time before the expiry of 3 months beginning from the date of grant and in the event of such payment the patent shall remain in force for the balance of the period of 4 years specified in subsection (2);
- (b) the patent shall cease to have effect under this section if, and only if, the prescribed renewal fee is not paid as provided in paragraph (a).

(4) The Registrar may by regulation amend the period specified in subsection (2) as being the period ending with the expiry of the 4th year from the date of filing of the short-term patent application.

(5) If within 6 months after the end of the period specified in subsection (2) or (3), as the case may be, the renewal fee and any prescribed additional fee is paid, the short-term patent shall be treated as if it had never expired, and accordingly—

- (a) anything done under or in relation to it during that further period shall be valid;
  - (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
  - (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.
- (6) The Governor in Council may by regulation amend—
- (a) the period specified in subsection (1)(b) as being the period for which a short-term patent shall remain in force;
  - (b) the period specified in subsection (2) or (3) by reference to which a short-term patent, if not renewed, shall cease to have effect.

[cf. 1977 c. 37 s. 25 U.K.]

## 127. Restoration of lapsed short-term patents

Sections 40 and 41 shall apply to short-term patents, with necessary modification, as if reference in those sections to a standard patent and to section 39 were a reference to a short-term patent and to section 126 respectively.

### Miscellaneous

#### 128. Disclosure of invention by specification; availability of samples of micro-organisms

(1) Provision may be made by rules prescribing the circumstances in which the specification of an application for a short-term patent, or of a short-term patent, for an invention which requires for its performance the use of a micro-organism is to be treated as disclosing the invention in a manner sufficiently clear and complete for the invention to be performed by a person skilled in the art.

(2) The rules may in particular require the applicant or proprietor—

(a) to take such steps as may be prescribed for the purposes of making available to the public samples of the micro-organism; and

(b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed; and the rules may identify a description of persons by reference to whether the Registrar has given his certificate as to any matter.

(4) An application for revocation of the short-term patent under section 91(1)(c) may be made if any of the requirements of the rules cease to be complied with.

[*cf.* 1977 c. 37 s. 125A U.K.]

#### 129. Court proceedings in relation to short-term patents

(1) In any proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to a short-term patent—

(a) it is for the proprietor of the patent to establish the validity of the patent, and the fact that the patent has been granted under this Part shall be of no account in that regard;

(b) evidence by the proprietor which is sufficient to establish *prima facie* the validity of the patent shall in the absence of evidence to the contrary be sufficient proof of such validity.

(2) If in proceedings before the court under this Ordinance in relation to a short-term patent an order is made in interlocutory proceedings granting or refusing an application for an injunction under section 80(1)(a) or an order under section 80(1)(b), any party may apply to the court for an order that the matter proceed to early trial and, subject to compliance by that party with rules of court, the court shall so order unless it considers that the interests of justice would not be served by the making of such an order.

- (3) A court making an order for an early trial under subsection (2)—
- (a) may also make such order as respects the period before trial as the justice of the case requires;
  - (b) shall by the order determine the mode of trial.

## PART XVI

### MISCELLANEOUS

#### 130. Appeal from Registrar

(1) Except as otherwise expressly provided by rules, an appeal to the court shall lie from any decision or order of the Registrar under this Ordinance, and for the purposes of this provision “decision” (決定) includes any act of the Registrar in exercise of a discretion vested in him by or under this Ordinance.

(2) Any appeal under this Ordinance which concerns a patent application which has not been published shall be heard in private.

(3) In any appeal under this Ordinance—

(a) the Registrar shall be entitled to appear or be represented and be heard in support of his decision or order;

(b) the Registrar shall appear if so directed by the court.

(4) In any appeal under this Ordinance the court may exercise any power which could have been exercised by the Registrar in proceedings from which the appeal is brought.

#### 131. Registrar's appearance in proceedings involving register

(1) In any proceedings before the court involving an application for the alteration or rectification of the register, the Registrar shall be entitled to appear or be represented and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the Registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of—

(a) any proceedings before him in relation to the matter in issue;

(b) the grounds of any decision given by him affecting it;

(c) the practice of the registry in like cases; or

(d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.



### 132. General powers of the court

(1) The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Ordinance, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

(2) Every order of the court shall be subject to appeal to the Court of Appeal.

[*cf.* 1977 c. 37 s. 99 U.K.]

### 133. Procedure in case of option to apply to court or Registrar

(1) Where under this Ordinance an applicant has an option to make an application either to the court or to the Registrar—

- (a) if an action concerning the patent or application for a patent in question is pending, the application must be made to the court;
- (b) if in any other case the application is made to the Registrar, the Registrar may, at any stage of the proceedings, refer the application to the court, or he may, after hearing the parties, determine the question between them, subject to appeal to the court.

(2) Subsection (1) is without prejudice to the court's powers, apart from this section, to determine any question referred to in that subsection.

(3) Reference in subsection (1) to an option to make an application either to the court or to the Registrar includes reference to an option to refer a question either to the court or to the Registrar.

[*cf.* Trade Marks Ord. s. 80]

### 134. Burden of proof in certain cases

(1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

[*cf.* 1977 c. 37 s. 100 U.K.]

### **135. Exercise of Registrar's discretionary powers**

Without prejudice to any rule of law, the Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by this Ordinance or by the rules.

[*cf.* 1977 c. 37 s. 101 U.K.]

### **136. Costs and expenses in proceedings before the court**

(1) Subject to subsection (2), in all proceedings before the court under this Ordinance the court may award to any party such costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

(2) In proceedings before the court under section 58 the court shall, in determining whether to award costs or expenses to any party and what costs or expenses to award, have regard to all the relevant circumstances, including the financial position of the parties.

(3) If in any such proceedings the court directs that any costs of one party shall be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs shall be taxed on a scale specified by the court, being a scale of costs prescribed by rules of court.

[*cf.* 1977 c. 37 s. 106 U.K.]

### **137. Costs and expenses in proceedings before Registrar**

(1) The Registrar may, in proceedings before him under this Ordinance, by order award to any party such costs as he may consider reasonable and direct how and by what parties they are to be paid.

(2) Any costs awarded under this section shall, if the court so orders, be recoverable by execution issued from the court as if they were payable under an order of that court.

(3) Rules may empower the Registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal, and may provide for the consequences if security is not given.

[*cf.* 1977 c. 37 s. 107 U.K.]

**138. Licences granted by order of the court or Registrar**

Any order for the grant of a licence under section 14, 56, 64 or 65 shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the standard patent and all other necessary parties, granting a licence in accordance with the order.

[*cf.* 1977 c. 37 s. 108 U.K.]

**139. Immunity of Registrar as regards official acts**

Neither the Registrar nor any officer of his—

- (a) shall be taken to warrant the validity of any patent granted under this Ordinance; or
- (b) shall incur any liability by reason of or in connection with any examination or investigation required or authorized by this Ordinance, or any report or other proceedings consequent on any such examination or investigation.

[*cf.* 1977 c. 37 s. 116 U.K.]

**140. Recognition of agents**

(1) Subject to this section and to the rules, where under this Ordinance any act has to be done by or to any person in connection with a patent or any procedure relating to a patent or the obtaining of a patent, the act may be done by or to an agent of such person duly authorized by that person orally or in writing.

(2) A person duly authorized by another person under subsection (1) to act as his agent may (subject to any provision to the contrary in any agreement between the agent and that person), on giving notice to the Registrar and the other person, cease to act as agent for the other person.

(3) Rules may authorize the Registrar to refuse to recognize as agent in respect of any business under this Ordinance any person specified for the purpose in the rules.

(4) The Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong.

**PART XVII****OFFENCES****141. Falsification of register, etc.**

A person who—

- (a) makes or causes to be made a false entry in any register kept under this Ordinance, knowing the entry to be false; or
- (b) makes or causes to be made a writing falsely purporting to be a copy or reproduction of an entry in any register kept under this Ordinance, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the writing to be false,

commits an offence and is liable—

- (i) on summary conviction, to a fine at level 5 and to imprisonment for 6 months;
- (ii) on conviction on indictment, to imprisonment for 2 years.

[*cf.* 1977 c. 37 s. 109 U.K.]

#### 142. Unauthorized claim of patent rights

(1) Subject to this section, a person who falsely represents that anything disposed of by him for value is a patented product commits an offence and is liable on summary conviction to a fine at level 3.

(2) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word "patent" or "patented" or "專利" or "享有專利" or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(3) Subsection (1) does not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(4) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

[*cf.* 1977 c. 37 s. 110 U.K.]

#### 143. Unauthorized claim that patent has been applied for

(1) Subject to this section, a person who represents that a patent has been applied for in respect of any article disposed of for value by him when in fact—

(a) no such application for a patent has been made; or

(b) any such application has been withdrawn or deemed withdrawn,

commits an offence and is liable on summary conviction to a fine at level 3.

(2) Subsection (1)(b) does not apply where the representation is made (or continues to be made) before the expiry of a period which begins with the withdrawal or deemed withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(3) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words "patent applied for" or "patent pending" or "已申請專利" or "專利申請待決", or anything expressing or implying that an application has been made for a patent in respect of the article, shall be taken to represent that an application for such a patent has been made.

(4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

[*cf.* 1977 c. 37 s. 111 U.K.]

#### 144. Misuse of title "Patents Registry"

A person who uses on his place of business, or any document issued by him, or otherwise, the words "Patents Registry" or "專利註冊處" or any other words suggesting that his place of business is, or is officially connected with, the Patents Registry, commits an offence and is liable on summary conviction to a fine at level 4.

[*cf.* 1977 c. 37 s. 112 U.K.]

#### 145. Offences by corporations or partners

(1) Where an offence under this Ordinance committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.

(2) The following provisions apply for the purposes of proceedings for an offence under this Ordinance alleged to have been committed by a body corporate—

- (a) any rules of court relating to the service of documents;
- (b) section 19A (plea by a corporation before a magistrate) and section 87 (procedure on charge of indictable offence against corporation) of the Magistrates Ordinance (Cap. 227).

(3) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

(4) Where a partnership is guilty of an offence under this Ordinance, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.

(5) Without prejudice to any liability of the partners under subsection (4), proceedings for an offence under this Ordinance alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of the partners.

(6) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(7) Where an offence under this Ordinance committed by a partner in a firm is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, any other partner in the firm or any person concerned in the management of the firm, that partner or the person concerned in the management of the firm is also guilty of the offence and liable to be proceeded against and punished accordingly.

## PART XVIII

### ADMINISTRATIVE PROVISIONS

#### **146. Correction of errors in patents and applications**

(1) The Registrar may, subject to the rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

(2) Where the Registrar is requested to correct such an error or mistake any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter.

*[cf. 1977 c. 37 s. 117 U.K.]*

#### **147. Information about patent applications and patents, and inspection of documents**

(1) After publication of an application for a standard patent in accordance with section 20 or the grant of a short-term patent the Registrar shall upon the filing of a written request in the prescribed manner give the person making the request such information, and permit him to inspect such documents, relating to the application or any patent granted in pursuance of the application or to the short-term patent as may be specified in the request, subject, however, to any prescribed restrictions.

(2) Subject to this section, until an application for a standard patent is so published or a short-term patent is granted documents or information constituting or relating to the application for the standard patent or the short-term patent shall not, without the consent of the proprietor or the applicant (as the case may be), be published or communicated to any person by the Registrar.

(3) Subsection (2) shall not prevent the Registrar from publishing or communicating to others any prescribed bibliographic information about an unpublished application for a standard patent or an application for a short-term patent.

(4) Where a person is notified that an application for a standard patent has been made, but not published in accordance with section 20, and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification after the application is so published, that person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly.

(5) Where a person is notified that an application for a short-term patent has been made and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification, that person may make a request under subsection (1) and that subsection shall apply accordingly.

(6) Where an application for a standard patent is filed, but not published, and a new application for a standard patent is filed in respect of any part of the subject-matter of the earlier application (either in accordance with the rules or in pursuance of an order under section 13) and is published, any person may make a request under subsection (1) in the prescribed manner relating to the earlier application and the Registrar shall give him such information and permit him to inspect such documents as could have been given or inspected if the earlier application had been published.

[*cf.* 1977 c. 37 s. 118 U.K.]

#### **148. Hours of business and excluded days**

(1) The Registrar may, by notice published in the Gazette, give directions specifying the hours of business of the registry for the purpose of the transaction by the public of business under this Ordinance, and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Ordinance expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions made under this section may make different provision for different classes of business.

#### 149. Rules

(1) The Registrar may make rules—

- (a) for the purposes of any provision of this Ordinance authorizing the making of rules (other than rules of court) with respect to any matter; and
- (b) for prescribing anything authorized or required by an provision of this Ordinance to be prescribed,

and generally for regulating practice and procedure under this Ordinance.

(2) Without prejudice to the generality of subsection (1), rules may make provision—

- (a) in connection with applications for patents and other documents which may be filed with the Registrar—
  - (i) prescribing the form and contents of any such documents;
  - (ii) requiring copies of such documents to be furnished;
  - (iii) prescribing the manner of filing of such documents;
- (b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or in the registry and authorizing the rectification of irregularities of procedure;
- (c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the registry and providing for the remission of fees in the prescribed circumstances;
- (d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;
- (e) requiring the Registrar to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;
- (f) providing for the appointment of advisers to assist the Registrar in any proceedings before him;
- (g) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Ordinance or the rules and providing for the alteration of any period of time specified in this Ordinance or the rules;
- (h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;



- (i) without prejudice to any other provision of this Ordinance, requiring and regulating the translation of documents in connection with a patent or an application for a patent into the language of the proceedings or into one or both official languages and the filing and verification of any such translations;
  - (j) providing for the publication and sale of documents by the registry and of information about such documents;
  - (k) prescribing opposition or revocation proceedings in designated patent offices for the purposes of sections 43 and 44.
- (3) Rules may make different provision for different cases.
- (4) Rules made under this section—
- (a) authorizing the rectification of irregularities of procedure; or
  - (b) providing for the alteration of any period of time,

may authorize the extension or further extension of any period of time notwithstanding that the period has already expired.

(5) Rules prescribing fees, including any penalty fee under section 104(5)(b), shall not be made except with the consent of the Financial Secretary.

(6) Any rules made under subsection (2)(c) may—

- (a) prescribe fees fixed at; or
- (b) provide for fees to be fixed at,

levels that provide for the recovery of expenditure incurred or likely to be incurred by the Government or other authority in the exercise of any or all functions under this Ordinance, and shall not be limited by reference to the amount of administrative or other costs incurred or likely to be incurred in the exercise of any particular function.

(7) Rules may provide for arrangements to be made by the Registrar for the publication of reports of cases relating to patents decided by the Registrar and of cases relating to patents (whether under this Ordinance or otherwise) decided by any court or body (whether in Hong Kong or elsewhere).

[*cf.* 1977 c. 37 s. 123 U.K.]

## 150. Registrar may specify forms to be used

(1) The Registrar may require the use of such forms as he may, by notice published in the Gazette, specify in connection with the granting of a patent or any other proceeding before him under this Ordinance.

(2) A notice under subsection (1) may contain any direction of the Registrar with respect to the use of a form specified in the notice.

**151. Ordinance binding on Government**

Subject to the provisions of this Ordinance, and notwithstanding section 5(3) of the Crown Proceedings Ordinance (Cap. 300), this Ordinance binds the Government.

[*cf. Registration of Patents Ord. s. 7A*]

**152. Forfeited articles**

Nothing in this Ordinance affects the right of the Government or any person deriving title directly or indirectly from the Government to dispose of or use articles forfeited under the law relating to customs or excise.

[*cf. 1977 c. 37 s. 122 U.K.*]

**153. Amendment of Schedule 1**

The Governor in Council may by order published in the Gazette—

- (a) add to Schedule 1 the name of—
  - (i) any country which has acceded to the Paris Convention;
  - (ii) any country, territory or area which has acceded to the World Trade Organisation Agreement;
- (b) delete from the Schedule 1 the name of—
  - (i) any country which has denounced the Paris Convention;
  - (ii) any country, territory or area which has denounced the World Trade Organisation Agreement.

**PART XIX****REPEALS AND TRANSITIONAL ARRANGEMENTS****154. Repeal**

- (1) The Registration of Patents Ordinance (Cap. 42) is repealed.
- (2) The repeal effected by subsection (1) is subject to the following provisions of this Part.

**155. Validity of instruments made or things done under the repealed Ordinance**

Insofar as any instrument made or other thing done at any time under any provision of the repealed Ordinance could have been made or done under a corresponding provision of this Ordinance it shall not be invalidated by the repeals made by this Ordinance but shall have effect as if made or done under that corresponding provision.

### 156. Use of patented inventions for service of the Crown

(1) Section 7G of the repealed Ordinance (which deals with the question of acts done by the Government as constituting the use of an invention for the services of the Crown, and payment falling to be made in respect of any such use) as it applied immediately before the commencement date shall continue in force.

(2) For ease of reference, section 7G of the repealed Ordinance as applying for the purposes of subsection (1) is set out in Schedule 2.

(3) Where a patent for an invention has been granted under this Ordinance pursuant to this Part to the proprietor of an existing registered patent for that invention, or to the applicant of a pending application for registration of a patent for that invention under the repealed Ordinance, sections 69 to 72 shall apply to Government use of such invention during any period of extreme urgency declared under section 68, subject to any necessary modifications.

### 157. Infringement

(1) Any question whether an act done before the commencement date infringes an existing registered patent shall be determined in accordance with the law relating to infringement in force immediately before the commencement date, and sections 6 and 7 of the repealed Ordinance shall apply accordingly.

(2) Subject to subsection (3) and to necessary modification—

- (a) sections 73 to 75, 80, 81, 85 to 87, 89 and 90 shall apply to any act done on or after the commencement date which infringes an existing registered patent; and
- (b) sections 82 to 84 shall apply to any such act which infringes an existing registered 1977 Act patent,

as those sections apply to infringements of a patent granted under this Ordinance.

(3) Where an act is commenced before the commencement date and continues to be done on or after that date then if that act would not, under the law in force immediately before that day, amount to an infringement of an existing registered patent for an invention it shall not amount to an infringement of any patent for that invention which may be granted under this Ordinance pursuant to this Part.

### 158. Rules providing for transitional arrangements

(1) The Governor in Council may, subject to the approval of the Legislative Council, make rules providing for the application of this Ordinance and the continued application of the repealed Ordinance to—

- (a) existing registered patents;
  - (b) pending applications for registration of a patent under the repealed Ordinance, and patents registered pursuant to such applications;
  - (c) existing 1949 Act or 1977 Act patents;
  - (d) published applications for 1977 Act patents and patents granted after the commencement date pursuant to such applications;
  - (e) existing applications for 1949 Act patents and patents granted after the commencement date pursuant to such applications.
- (2) Without prejudice to the generality of subsection (1), rules made under that subsection may provide for—
- (a) existing registered patents to be treated as standard patents granted under this Ordinance;
  - (b) the registration of patents under the repealed Ordinance pursuant to pending applications for such registration, and for patents so registered to be treated as existing registered patents;
  - (c) the grant of a standard patent to the proprietor of an existing 1949 Act or 1977 Act patent;
  - (d) an application for a standard patent by the applicant of a published application for a 1977 Act patent, and the grant of a standard patent to the proprietor of a patent granted pursuant to such an application after the commencement date;
  - (e) the grant of a standard patent to the proprietor of a 1949 Act patent granted after the commencement date pursuant to an existing application for the 1949 Act patent.
- (3) Rules made under subsection (1) may further provide—
- (a) for time limits for making any application for a patent pursuant to rules made under this Part;
  - (b) for the application of this Ordinance to any patent or application for a patent provided for in this Part or in rules made under this Part;
  - (c) subject to any rules that may be made under paragraph (d), that no amendment or revocation of an existing registered patent in the United Kingdom taking effect on or after the commencement date shall have any effect for the purposes of any patent granted under this Ordinance pursuant to this Part, notwithstanding that such amendment or revocation may have effect in the United Kingdom as from a date prior to the commencement date;
  - (d) for the amendment or revocation of a standard patent for an invention granted under this Ordinance pursuant to this Part following the amendment or revocation in the United Kingdom of a 1949 Act patent for that invention;

- (e) for modifications to this Ordinance as it is applied for the purpose of any provision of this Part;
- (f) for the resolution of questions of priority as between—
  - (i) 1949 Act patents and patent applications;
  - (ii) 1977 Act patents and patent applications; and
  - (iii) patents and patent applications under this Ordinance;
- (g) for the transfer to the register kept under this Ordinance of details of patents registered under the repealed Ordinance before the commencement date, and for matters connected with the keeping of the register in relation to such details, and in that connection rules may provide for—
  - (i) rectification of the register in relation to such details;
  - (ii) application by any person for the inclusion in the register of such details;
- (h) for the amendment by the Registrar by notice published in the Gazette of any time limit specified in, or any Schedule to, such rules.

### 159. Interpretation (Part XIX)

(1) In this Part, unless the context otherwise requires—

“1949 Act” (《1949年法令》) means the Patents Act 1949 (1949 c. 87 U.K.), and “1949 Act patent” (1949年法令專利) means a patent granted under that Act or under the 1977 Act pursuant to an application under the 1949 Act;

“1977 Act” (《1977年法令》) means the Patents Act 1977 (1977 c. 37 U.K.), and “1977 Act patent” (1977年法令專利) means a patent granted under that Act pursuant to an application made before the commencement date and means also a European patent (UK) that has effect in the United Kingdom pursuant to section 77 of the 1977 Act;

“commencement date” (生效日期) means the date appointed under section 1(2) as being the date on which this Ordinance comes into operation;

“European patent (UK)” (歐洲專利(聯合王國)) means a patent granted under the Convention on the Grant of European Patents (European Patent Convention) and designating the United Kingdom;

“existing 1949 Act or 1977 Act patent” (現有的1949年法令或1977年法令專利) means a 1949 Act or 1977 Act patent—

- (a) granted before the commencement date and capable as at that date of registration under the repealed Ordinance; and
- (b) for which as at the commencement date no valid application for registration under the repealed Ordinance had been made;

“existing application for a 1949 Act patent” (1949 年法令專利的現有申請) means an application for a patent made under the 1949 Act, in respect of which as at the commencement date a patent had not been granted;

“existing registered patent” (現有註冊專利) means a 1949 Act or 1977 Act patent which—

- (a) was registered under the repealed Ordinance before the commencement date; and
- (b) at the commencement date—
  - (i) was still in force in the United Kingdom;
  - (ii) had ceased to have effect in the United Kingdom, but subsequently is treated for the purposes of the 1977 Act as having never expired; or
  - (iii) had ceased to have effect in the United Kingdom but subsequently is restored by an order made under the 1977 Act;

“pending application for registration of a patent under the repealed Ordinance” (待決的將專利根據已廢除條例註冊的申請) means an application made before the commencement date for registration of a 1949 Act or 1977 Act patent under section 3 of the repealed Ordinance, but not as at that date registered under the repealed Ordinance;

“published application for a 1977 Act patent” (已發表的 1977 年法令專利的申請) means an application for a patent—

- (a) pursuant to which there could be granted a 1977 Act patent; and
- (b) published before the commencement date,

and in the case of an international application reference in paragraph (b) to publication shall be read as a reference to such publication of the application by a designated patent office as serves to indicate that the international application has validly entered its national phase;

“the repealed Ordinance” (已廢除條例) means the Registration of Patents Ordinance (Cap. 42).

(2) In this Part, unless the context otherwise requires—

- (a) a reference to the registration of a patent under the repealed Ordinance is a reference to the issue of a certificate of registration under section 5 of that Ordinance in respect of that patent;
- (b) a reference to the repealed Ordinance is a reference to that Ordinance as it applied immediately before the commencement date;
- (c) a reference to a patent granted under this Ordinance pursuant to this Part includes a reference to a patent treated as so granted.

## Consequential Amendments

### Inland Revenue Ordinance

#### 160. Ascertainment of chargeable profits

Section 16(1)(g) of the Inland Revenue Ordinance (Cap. 112) is amended by repealing “, design or patent” and substituting “or design, or the registration or grant of a patent,”.

### Pesticides Ordinance

#### 161. Trademarks, trade descriptions, patents and copyright not affected

Section 20 of the Pesticides Ordinance (Cap. 133) is amended by repealing “Registration of Patents Ordinance (Cap. 42)” and substituting “Patents Ordinance (52 of 1997)”.

### Crown Proceedings Ordinance

#### 162. Provisions as to industrial property

Section 5(2) of the Crown Proceedings Ordinance (Cap. 300) is amended by repealing—

- (a) the passage beginning “section 46” and ending “U.K.), or”;
- (b) “the Registration of Patents Ordinance (Cap. 42), and”;
- (c) “respectively”.

### Director of Intellectual Property (Establishment) Ordinance

#### 163. “專利註冊處處長” substituted for “專利權註冊處處長”

Section 7(1), (2) and (3) and Schedule 2 of the Director of Intellectual Property (Establishment) Ordinance (Cap. 412) is amended by repealing “專利註冊處處長” wherever it occurs and substituting “專利註冊處處長”.

## SCHEDULE 1

[ss. 2 &amp; 153]

## PARIS CONVENTION COUNTRIES AND WTO MEMBER COUNTRIES, TERRITORIES AND AREAS

**Paris Convention countries**

The following are specified for the purposes of the definition of "Paris Convention country" in section 2(1) as countries which have acceded to the Paris Convention—

Albania  
Algeria  
Argentina  
Armenia  
Australia  
Austria  
Azerbaijan  
Bahamas  
Bangladesh  
Barbados  
Belarus  
Belgium  
Benin  
Bolivia  
Bosnia and Herzegovina  
Brazil  
Bulgaria  
Burkina Faso  
Burundi  
Cameroon  
Canada  
Central African Republic  
Chad  
Chile  
China  
Colombia  
Congo  
Costa Rica  
Cote d'Ivoire  
Croatia  
Cuba  
Cyprus  
Czech Republic  
Democratic People's Republic of Korea  
Denmark  
Dominican Republic  
Egypt



El Salvador  
Equatorial Guinea  
Estonia  
Finland  
France  
Gabon  
Gambia  
Georgia  
Germany  
Ghana  
Greece  
Guinea  
Guinea-Bissau  
Guyana  
Haiti  
Holy See  
Honduras  
Hungary  
Iceland  
Indonesia  
Iran (Islamic Republic of)  
Iraq  
Ireland  
Israel  
Italy  
Japan  
Jordan  
Kazakstan  
Kenya  
Kyrgyzstan  
Latvia  
Lebanon  
Lesotho  
Liberia  
Libya  
Liechtenstein  
Lithuania  
Luxembourg  
Madagascar  
Malawi  
Malaysia  
Mali  
Malta  
Mauritania  
Mauritius

Mexico  
Monaco  
Mongolia  
Morocco  
Netherlands  
New Zealand  
Nicaragua  
Niger  
Nigeria  
Norway  
Panama  
Paraguay  
Peru  
Philippines  
Poland  
Portugal  
Republic of Korea  
Republic of Moldova  
Romania  
Russian Federation  
Rwanda  
Saint Kitts and Nevis  
Saint Lucia  
Saint Vincent and the Grenadines  
San Marino  
Senegal  
Sierra Leone  
Singapore  
Slovakia  
Slovenia  
South Africa  
Spain  
Sri Lanka  
Sudan  
Suriname  
Swaziland  
Sweden  
Switzerland  
Syria  
Tajikistan  
The former Yugoslav Republic of Macedonia  
Togo  
Trinidad and Tobago  
Tunisia  
Turkey

Turkmenistan  
Uganda  
Ukraine  
United Arab Emirates  
United Kingdom  
United Republic of Tanzania  
United States of America  
Uruguay  
Uzbekistan  
Venezuela  
Viet Nam  
Yugoslavia  
Zaire  
Zambia  
Zimbabwe

**WTO member countries, territories  
and areas (not including Paris  
Convention countries)**

The following are specified as being countries, territories or areas which have acceded to the World Trade Organisation Agreement—

Angola  
Antigua and Barbuda  
Bahrain  
Belize  
Botswana  
Brunei Darussalam  
Djibouti  
Dominica  
Ecuador  
European Community  
Fiji  
Grenada  
Guatemala  
India  
Jamaica  
Kuwait  
Macau  
Maldives  
Mozambique  
Myanmar  
Namibia  
Pakistan  
Papua New Guinea  
Qatar  
Sierra Leone  
Solomon Islands  
Thailand

## SCHEDULE 2

[s. 156(2)]

## REGISTRATION OF PATENTS ORDINANCE

Section 7G of the Registration of Patents Ordinance (Cap. 42) as applying for the purposes of section 156(1) of this Ordinance reads—

**“7G. Transitional**

(1) Any question whether—

- (a) an act done before the commencement date by the Government or a person authorized by the Governor under section 7B, as it read immediately before the commencement date, constitutes the use of a patented invention for the services of the Crown, or
- (b) any payment falls to be made in respect of any such use (whether to a person entitled to register a patent for the invention, to the patentee or to an exclusive licensee),

shall be determined in accordance with sections 7B to 7D as they read immediately before the commencement date.

(2) Where an act is begun before the commencement date and continues to be done on or after that date, then, if that act would under the law in force immediately before that date constitute use of a patented invention for the services of the Crown, its continuance shall constitute Crown use under this Ordinance and shall not constitute an infringement.

(3) In this section, “commencement date” means the date on which section 11 of the Intellectual Property (World Trade Organization Amendments) Ordinance 1996 (11 of 1996) comes into operation.”